1

Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.

DRAWING(S):

The drawings in the application are accepted. No drawing amendments are submitted with this amendment.

1

Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.

REMARKS – General

The applicant has made no amendments to the specification. Applicant has currently amended claims 27, 29, and 32 to define the claims more distinctly. Applicant has withdrawn claims 39-53 and added 6 new claims. The new claims 54 to 59 contain no new matter, and the recited elements are derived from the applicant's previous claims 24,25,27,29,32,35 and specification. Applicant has made no drawing amendments.

Applicant has answered the "Response to Arguments" section and the §112 rejections. Applicant has reiterated the text for claims 24,25,27,29,32, and 35 under §102 and §103 from previous Amendment C. Applicant has added or updated some of the reasons and text, and has underlined them as stated throughout.

The above previously presented claims, currently amended claims, and new claims are submitted to be patentable over the art of record for the following reasons.

Re: O.A. "Response to Arguments"

The applicant thanks the Examiner for the final Office Action.

The Office Action stated at #1: "Applicant's arguments filed 6-6-11 have been fully considered but they are not persuasive. Applicant has agreed that the prior art, Martinez et al. (7,519,576) does show a dictionary feature but is just arranged differently. Martinez et al. clearly show in the Abstract that a dictionary or thesaurus could be used. Applicant has argued about the omission of elements. These elements are not in the claims. Applicant has added new claims 39-52 which are rejected as not filed in the original presentation. The following rejections still exist:".

The applicant, regarding "arranged", has **added the cited case under MPEP 2131 of "In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)" to each MPEP 2131 reason.** The point about the omission of elements that are not in the claims is unclear. The omission of elements arguments require that the listed elements not be recited in the claims, and for good measure are also not written in applicant's specification. The applicant requests clarification about the omission of elements that are not persuasive. The applicant respectfully points out that the added new claims are not 39-52, but are instead 39-53 and has withdrawn claims 39-53.

The Office Action stated at #2: "Newly submitted claims 39-52 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: they add

1

Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.

the additional features of a "sense of a word", "menu choices", and "selecting different meanings".

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 39-52 are withdrawn from consideration as being directed to a non-elected invention. See CFR 1.142(b) and MPEP § 821.03."

The applicant points out that withdrawn claims 39-53 do not recite verbatim "sense of a word", "menu choices", and "selecting different meanings". The applicant thanks the Examiner for pointing out, during a phone interview, that the office action serves as a requirement for restriction to a non-elected invention in claims 39-53. The applicant plans, as discussed in the interview, to submit a divisional application on the non-elected invention in a Preliminary Amendment. The Examiner confirmed that 35 USC § 121 is applicable to the planned divisional application.

The Claim Rejections Under 35 USC § 112

The O.A. stated:

"1. The following is a quotation of the second paragraph of 35 U.S.C. 112: The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 24,25,27,29,32 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In regard to claim 24, "simple and convenient manner" is vague and indefinite. This also seems to be an intended use. It should be deleted from the claim.

The Rejection of Independent Claim 24 Overcome Under § 112

The O.A. rejected independent claim 24 under 35 U.S.C. 112, second paragraph, as being vague and indefinite in regards to "simple and convenient manner". The O.A. further stated "This also seems to be an intended use."

Previously presented claim 24 recites:

"A process of providing dictionary content for a word, comprising:

(a) providing a computer,

(b) presenting a word displayed on a screen,

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

    (c) implementing a pop up digital space on said screen,

    (d) utilizing a dictionary element for said word on said screen, and

    (e) displaying said pop up digital space to present said dictionary element on said

        screen when a cursor is placed over said word,

whereby the dictionary content is presented in a simple and convenient manner for computer

users."

The applicant disagrees with the O.A. regarding claim 24 and its "simple and convenient

manner". Since the phrase is recited in a whereby clause, it recites a **result**. Thus the applicant

disagrees with the O.A. that the "simple and convenient manner" of claim 24 "seems to be an

intended **use**".

The MPEP at 2111.04 states "However, the court noted (quoting *Minton v. Nat'l Ass'n of*

Securities Dealers, Inc., 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a

"'whereby clause in a method claim is not given weight when it simply expresses the intended

result of a process step positively recited.'"

The "simple and convenient manner" of claim 24 is supported in applicant's specification. The

phrase is described verbatim under the heading of "Objects and Advantages" in first entry "(a)".

The applicant submitted this merit of the application's specification because of necessity. This merit of

the application was not earlier presented because this current O.A. stated for the first time that "In regard

to claim 24, "simple and convenient manner" is vague and indefinite. This also seems to be an

intended use. It should be deleted from the claim."

Therefore claim 24 contains no amendments. The applicant requests reconsideration and

allowance of previously presented independent claim 24 under 35 U.S.C. § 112.

The Rejection of Dependent Claims 25,27,29,32 and 35 Under § 112

The O.A. rejected claims 25,27,29,32 and 35 under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

The O.A. has not clearly communicated the reasons for rejecting claims 25,27,29,32 and 35

under 35 U.S.C. 112.

Claim 27 Is Currently Amended Under § 112

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

Claim 27 recites: "The process of Claim 24 further including displaying said pop up digital space presents a video when said cursor is placed over said word."

Claim 27 is currently amended in the following way with the accompanying reason:

1. The "further including" is deleted after "process of Claim 24" and replaced with "wherein" to make claim 27 clear, precise and logical under § 112, second paragraph.

Thus claim 27, as currently amended, now recites:

"The process of Claim 24 ~~further including~~ <u>wherein</u> displaying said pop up digital space presents a video when said cursor is placed over said word."

Therefore rejected claim 27 is currently amended to distinctly claim the subject matter, and to make the claim clear and understandable. No new matter has been added. The applicant submits the currently amended claim 27 places the claim in better form for consideration and requests allowance under 35 U.S.C. § 112.

Claim 29 Is Currently Amended Under § 112

Claim 29 recites: "The process of Claim 24 wherein having said dictionary element presents more than one meaning of said word the intended contextual meaning of said word is highlighted."

Claim 29 is currently amended in the following ways with the accompanying reasons:

1. The "having" is deleted after "wherein" and replaced with "displaying" to make claim 29 clear, precise and logical under § 112, second paragraph.

2. The "that" is added after "said dictionary element" to make claim 29 clear and precise under § 112, second paragraph.

3. The comma "," is added after "of said word" to make claim 29 clear and precise under § 112, second paragraph.

Thus claim 29, as currently amended, now recites:

"The process of Claim 24 wherein ~~having~~ <u>displaying</u> said dictionary element <u>that</u> presents more than one meaning of said word, the intended contextual meaning of said word is highlighted."

Therefore rejected claim 29 is currently amended to distinctly claim the subject matter, and to make the claim clear and understandable. No new matter has been added. The applicant submits the currently amended claim 29 places the claim in better form for consideration and requests allowance under 35 U.S.C. § 112.

1

Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.

Claim 32 Is Currently Amended Under § 112

Claim 32 recites: "The process of Claim 24 wherein showing said dictionary element is presented with respect to an intended audience."

Claim 32 is currently amended in the following ways with the accompanying reasons:

1. The "showing" is deleted after "wherein" and replaced with "displaying" to make claim 32 clear, precise and logical under § 112, second paragraph.

2. The "that" is added after "said dictionary element" to make claim 29 clear and precise under § 112, second paragraph.

Thus claim 32, as currently amended, now recites:

"The process of Claim 24 wherein ~~showing~~ displaying said dictionary element that is presented with respect to an intended audience."

Therefore rejected claim 32 is currently amended to distinctly claim the subject matter, and to make the claim clear and understandable. No new matter has been added. The applicant submits the currently amended claim 32 places the claim in better form for consideration and requests allowance under 35 U.S.C. § 112.

The Rejection of Claims 24,25,27,29,32 and 35 on Martinez et al. Under § 102

The O.A. stated at #3: "The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language. "

The O.A. further stated at #4: "Claims 24,25,27,29,32 and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Martinez et al. (7,519,576).

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

In regard to claims 24,25,27,29,32 and 35, Martinez et al. show a method with a means for conveniently providing dictionary elements and other relevant elements of a word or phrase for computer users, comprising: (a) using a computer (Fig. 1, item 110), (b) utilizing a text displayed on a computer screen (Fig. 2, item 210), (c) having a cursor present on said computer screen (Fig. 2, item 220, col. 4, ln 20-25), whereby the dictionary elements for a word or phrase are presented in pop up digital spaces when said cursor is placed over said word or phrase in said text (Fig. 4), wherein said dictionary elements includes a definition presented in said pop up digital spaces (col. 1, ln 15-30, Fig. 4, item 710, claim 3 - said database is a dictionary), wherein said pop up digital spaces presents various images that includes digital video when said cursor is placed over said word or phrase in said text (claim 4 - graphical images), wherein said pop up digital spaces are menu driven and utilize the drag and selection methods of said cursor to select various choices in the menus (menu usage, col. 1, ln 40-55), wherein the dictionary elements that present more than one meaning of said word or phrase, the intended contextual meaning of said word or phrase can be highlighted or otherwise distinguished (Fig. 8, item 810), further including said dictionary elements presented in said pop up digital spaces are from a sources that includes published works (thesaurus and dictionary, claims 2 and 3), wherein said dictionary elements are to be used judiciously (Fig. 5), wherein said pop up digital spaces can present a plurality of said pop up digital spaces (Fig. 13), further including various images presented in said pop up digital spaces that are from a sources that includes professional works (claims 2-4), further including a computer machine that evolved to present said dictionary elements for said word or phrase in said pop up digital spaces (Fig. 13), wherein said cursor includes a mouse click selection method or touchscreen selection method (col. 5, ln 30-35)."

A Review of Applicant's Application:

The applicant provides at least one pop up digital space containing a dictionary entry for a word in a text in a fast and convenient manner. The pop up digital space appears when a computer cursor is placed over the word. The dictionary entry includes and is not limited to syllable breaks, pronunciations, parts of speech, senses, definitions, synonyms, antonyms, variants, usages, quotations, idioms, homographs, prefixes, suffixes, example sentences, and etymologies. Multimedia imagery can be presented such as photographs, drawings, paintings, maps,

1

Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.

illustrations, films, videos, claymation, stop action, and animations. Such multimedia is intended to help users to better understand a word or a phrase.

A Review of the Reference of Martinez:

Martinez et al. (hereinafter Martinez) provides a mechanism, called a recursive search process, for thoroughly searching a target item in a database, and displaying the similar items for a user to select and replace the target item.

On a main application the recursive search process begins at a cursor's position and a target item is identified. A database is searched for items similar to the target item. An indicator near the target item shows the existence of the items similar. A user may click for access to display the items similar in a pop-up window. In response to a command for replacement, a user clicks on a similar item to replace the target item in the main application. The main application may be a word processor, text editor, drawing software, drafting software, purchasing software, or some other application. Any one of the items similar displayed in the pop-up window may then become a target item. The invention describes a recursive annotation function, a recursive pop-up display function, and a function for placing an order to buy an item.

The Rejection of Independent Claim 24 on Martinez Overcome Under § 102

The O.A. stated, regarding applicant's claim 24, "Martinez et al. show a method with a means for conveniently providing dictionary elements and other relevant elements of a word or phrase for computer users, comprising: (a) using a computer (Fig. 1, item 110), (b) utilizing a text displayed on a computer screen (Fig. 2, item 210), (c) having a cursor present on said computer screen (Fig. 2, item 220, col. 4, In 20-25), whereby the dictionary elements for a word or phrase are presented in pop up digital spaces when said cursor is placed over said word or phrase in said text (Fig. 4),".

Instead previously presented independent claim 24 recites:

"A process of providing dictionary content for a word, comprising:

   (a) providing a computer,

   (b) presenting a word displayed on a screen,

   (c) implementing a pop up digital space on said screen,

   (d) utilizing a dictionary element for said word on said screen, and

   (e) displaying said pop up digital space to present said dictionary element on said

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

screen when a cursor is placed over said word,

whereby the dictionary content is presented in a simple and convenient manner for computer

users.

<u>Since claim 24 contains no amendments, the reasons under § 102 and § 103 from previous</u>

<u>Amendment C are the same, and are reiterated here for the sake of convenience and</u>

<u>completeness. Some reasons and text are updated, and 1 new reason is added under § 102, and</u>

<u>these are indicated by underlined text.</u>

<u>The applicant has corrected the reasons containing the typographical error regarding "(Fig. 2,</u>

<u>item 220, col. 4, In 20-25)". These updated reasons also have the underlined text.</u>

The applicant respectfully disagrees that Martinez describes claim 24 for the following reasons:

1. The O.A. stated at #1: "...Martinez et al. clearly show in the Abstract that a dictionary or

thesaurus could be used."

Martinez describes in his abstract section, "This might involve inserting a word into text with a

word processor; the items may be words, and the database may be a thesaurus or dictionary, for

example."

Martinez describes that his database is or may be a dictionary 6 other times as follows:

Martinez's claim 3 recites "and said database is a dictionary", his claim 13 recites "and the

database may be a thesaurus or dictionary", his claim 20 recites "and said database is a

dictionary", his claim 30 recites "and said database is a dictionary", he describes at (col. 2, In 50-

51), "and the database may be a thesaurus or dictionary,", and he describes at (col. 6, In 9-10),

"Database 1030 may be a thesaurus or dictionary,".

Martinez mentions a "reverse electronic dictionary" which is discussed below in reason #3.

Claim 24 is novel over Martinez due to MPEP 2131 and its application of <u>§ 102 *In re Bond*, 910</u>

<u>F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990),</u> which states:

The elements must be arranged as required by the claim, but this is not an *ipsissimis*

verbis test, i.e., identity of terminology is not required.

Martinez and his 7 descriptions regarding **a database is or may be a dictionary are not**

arranged as required by claim 24. Claim 24 recites "(e) displaying said pop up digital space to

present said dictionary element on said screen when a cursor is placed over said word,". <u>Hence</u>

<u>claim 24 recites a new arrangement that is novel over Martinez's arrangement.</u>

1

Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.

Thus claim 24 recites novel physical features that distinguish over Martinez.

2. The O.A. stated "In regard to claims...24...Martinez et al. show a method with a means for conveniently providing dictionary element and other relevant elements of a word for computer users, comprising: (a) using a computer (Fig. 1, item 110), (b) utilizing a text displayed on a computer screen (Fig. 2, item 210), (c) having a cursor present on said computer screen (Fig. 2, item 220, col. 4, In 20-25), whereby the dictionary element for said word are presented in pop up digital spaces when said cursor is placed over said word in said text (Fig. 4),".

The applicant respectfully points out that the O.A. stated, "a method with a means for conveniently providing dictionary element and other relevant elements of a word for computer users, comprising:". Instead claim 24 recites "A process of providing dictionary content for a word, comprising:".

Martinez shows in his (Fig. 1, item 110), a "processor".

Martinez shows in his (Fig. 2, item 210), a "print".

Martinez shows in his (Fig. 2, item 220), a "cursor".

Martinez describes at col. 4, In 20-25, "FIG. 2 illustrates one possible user interface display annotated with an indicator, according to the teachings of the present invention. Cursor 220 is positioned at the word "print," 210, in a line of text. This represents a line of text displayed by a main application such as a word processor or text editor."

Martinez shows in his (Fig. 4), a "target item" 410 of "print", a "in a pop-up window" 420, and a "similar items" 430 that are "copy, indentation, mark, picture, photograph, engraving, letter, type, edition, in print, fix, impress, publish, engrave, stamp".

Claim 24 recites "(d) utilizing a dictionary element for said word on said screen, and". Claim 24 is novel over Martinez's Fig. 1, Fig. 2, col. 4, In 20-25, and Fig. 4 that show his "**similar items**" to the "**target item**". This is because claim 24 and it's "**a dictionary element for said word**" distinguishes over Martinez and his "items" that are merely "**similar to the target item**".

Thus claim 24 recites a novel physical feature that distinguishes over Martinez from the aforementioned O.A. statement.

The Additional Novel Reasons of Claim 24 Over Martinez Under § 102: The applicant submits claim 24 is novel over Martinez for the following additional reasons:

1

Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.

3. Martinez describes at (col. 1, In 26-30), "Another example is U.S. Pat. No. 5,649,221
(**Crawford, et al.**, Jul. 15, 1997), which discloses a "reverse electronic dictionary;" the user
enters one or more search words which are thought to exist in the definition of the word that is
sought."

a. Claim 24 and its "(c) implementing a pop up digital **space** on said screen," is novel over
Crawford et al. (hereinafter Crawford) because Crawford does **not** describe a "pop up digital
space" anywhere in his invention.

b. Claim 24 and its "(d) utilizing a **dictionary element** for said word on said screen, and" is
novel over Crawford and his "**reverse electronic dictionary**".

c. Claim 24 is novel over Crawford due to MPEP 2131 and its application of § 102 *In re Bond*,
910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990), which states:

> The elements must be arranged as required by the claim, but this is not an *ipsissimis*
> *verbis* test, i.e., identity of terminology is not required.

Since Crawford does **not** describe a "pop up digital space" of claim 24, his invention of a
"**reverse electronic dictionary**" is **not arranged** as required by the claim. Claim 24 recites "(e)
displaying said pop up digital space to present said **dictionary element** on said screen when a
cursor is placed over said word,". Hence claim 24 recites a new arrangement that is novel over
Crawford's arrangement.

Thus claim 24 recites novel physical features that distinguish over Martinez and his reference of
Crawford.

4. Claim 24 recites "(d) utilizing a dictionary element for said word on said screen, and'.
Martinez describes at (col. 4, In 26-29), "The invention searches a database for **items similar to
the target item**, and provides an indicator, 230, near word 210's position, to show the existence
of similar items in said database."

Claim 24 is novel over Martinez because the claim's "dictionary element for said word" has the
preposition "for" which means "**with respect to**" (said word).

Instead Martinez describes "items similar to the target item" that has the preposition "**to**" which
does not mean "**with respect to**" (the target item). Hence Martinez and his "items similar to the
target item" is less about its "target item" than claim 24 and its "dictionary element **for** said
word".

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

Claim 24 and its "dictionary element for said word" is all about "said word", since as mentioned, the "for" means "with respect to" (said word).

Thus claim 24 is novel and distinguishes over Martinez.

5. Claim 24 recites "(d) utilizing a dictionary element for said word on said screen, and".

Martinez describes at (col. 4, In 26-29), "The invention searches a database for **items similar to the target item**, and provides an indicator, 230, near word 210's position, to show the existence of similar items in said database."

Claim 24 is novel over Martinez and his "**items similar to said target item**". This is because claim 24 and it's "**a dictionary element for said word**" distinguishes over Martinez and his "items" that are merely "**similar to the target item**".

Thus claim 24 recites novel physical features that distinguish over Martinez.

6. Claim 24 recites "(d) utilizing a dictionary element for said word on said screen, and".

Martinez describes at (col. 4, In 26-29), "The invention searches a database for **items similar to the target item**, and provides an indicator, 230, near word 210's position, to show the existence of similar items in said database."

Claim 24 and its "**dictionary element for said word**" is novel over Martinez and his "**items similar to said target item**". This is because claim 24 and its "**dictionary element**" is a **direct** meaning for a word that distinguishes over Martinez and his "**items**" that are merely "**similar to the target item**".

Thus claim 24 recites a novel physical feature that distinguishes over Martinez.

7. <u>Claim 24 recites "(e) displaying said pop up digital space to present said dictionary element on said screen when a cursor is placed over said word,".</u>

<u>**Martinez** describes at col. 4, In 26-27, "**Responsive to the cursor 220's position,** the invention identifies the word "print," 210, as a target item."</u>

<u>**Martinez** describes at col. 5, In 46-58, "FIG. 8 illustrates one possible user interface display involving an example of the invention's selection process. In this example, the item at 810 ("certified copy") is selected (shown by **cursor 520 pointing at item 810**). Responsive to a command for replacement (**the notation "click," 310**) the invention replaces a first item (the word "print" at 410) with an item from the database, "certified copy" at 810. The notation "click," 310, signifies a user sending a command, by clicking a mouse button, or touching a</u>

1

Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.

touch-sensitive screen with a stylus, or using some other input device. On the other hand, a user

could decide not to select any of the similar items at 710, **but rather utilize button 450 as a**

way to exit the pop-up display."

Thus Martinez describes a minimum of 3 selecting steps to use his invention at col. 4, In 26-27

and at col. 5, In 46-58.

Claim 24 is novel over Martinez due to MPEP 2131 and its application of § 102 *In re Bond*, 910

F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990), which states:

> The elements must be arranged as required by the claim, but this is not an *ipsissimis*
>
> *verbis* test, i.e., identity of terminology is not required.

Martinez and the minimum of 3 selecting steps to use his invention are **not arranged as required**

by claim 24. Claim 24 recites "(e) displaying said pop up digital space to present said dictionary

element on said screen when a cursor is placed over said word,". Hence claim 24 recites a new

arrangement that is novel over Martinez's arrangement.

Thus claim 24 recites novel physical features that distinguish over Martinez.

Therefore from the reasons discussed, the applicant submits that claim 24 is novel over

Martinez and requests reconsideration and allowance under 35 U.S.C. § 102.

Claim 24 Produces New and Unexpected Results and Hence is Unobvious and Patentable

Over Martinez Under § 103

The applicant submits that the novel physical features of previously presented claim 24 are also

unobvious and hence patentable under § 103 since they produce new and unexpected results over

Martinez, or any combination thereof.

Previously presented independent claim 24 recites:

"A process of providing dictionary content for a word, comprising:

(a) providing a computer,

(b) presenting a word displayed on a screen,

(c) implementing a pop up digital space on said screen,

(d) utilizing a dictionary element for said word on said screen, and

(e) displaying said pop up digital space to present said dictionary

element on said screen when a cursor is placed over said word,

whereby the dictionary content is presented in a simple and convenient manner for computer

1

Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.

users."

The new and unexpected results that flow from the novel physical features of claim 24 are discussed in the following reasons:

1. Omission of Elements: The numerous elements of Martinez that are omitted in claim 24 are: recursive search processes, items similar to the target item, indicator displays a number, showing how many similar items exist, indicator appears as a superscript number superimposed over a small translucent book icon, indicator that includes a function as an icon for sending a command for access or display, the notation "click", the replacement of the target item, on analyzing the context the word "print", for example, has been identified as a noun so similar nouns are listed first among similar items, the mechanism writes data to main application, the "No" branch is taken at decision, a "Yes" branch, lookup functions, lookup function stores a list of similar items, a selected similar item is inserted in place of an original item, inserting a word into text, recursive pop-up display function terminates at block 1390, similar items as images to a target item of an image, and similar items might be components of the same shape as the target item but with various dimensions or made of various materials than the target item, among other elements. Thus claim 24 is simpler than Martinez without loss of capability. Claim 24 is demonstrated in working models in which the numerous elements of Martinez are omitted.

2. Obviation of a Specific Disadvantage of an Existing Invention: Martinez teaches at (col. 4, ln 26-29), "The invention searches a database for **items similar to the target item**, and provides an indicator, 230, near word 210's position, to show the existence of similar items in said database."

Martinez and the "**items similar to the target item**" is a specific disadvantage of his invention in light of claim 24.

Claim 24 recites "(d) utilizing a dictionary element for said word on said screen, and". Claim 24 and it's "for said word" has the preposition "**for**" which means "**with respect to**" (said word). Since Martinez teaches the "items similar to the target item", it has the preposition "**to**". The preposition "**to**" **does not** mean "**with respect to**" (the target item). The specific disadvantage of Martinez is that his "items similar to the target item" is less about its "target item" than claim 24 and its "dictionary element for said word".

1

Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.

Claim 24 and its "dictionary element for said word" is all about "said word" because the "for" means "with respect to" (said word). This is an important advantage of claim 24 that is different than Martinez. Thus claim 24 overcomes a specific disadvantage of Martinez.

3. Cost: Claim 24 is likely to be cheaper to build per se than Martinez because the claim is a pure process. The low cost to build of claim 24 is demonstrated in working models made by low cost software. The software retails for $450 and is called "PowerPoint® 2007" which is part of the "Microsoft® Office Small Business 2007" suite containing 5 other programs.

The low cost result of claim 24 is different than Martinez because Martinez teaches machine parts from the title of his claims 28 to 37 of a "computer readable storage medium", and a "computer-usable medium". In addition Martinez's invention has numerous parts, steps and functions as discussed in the above subheading "1. Omission of Elements: ". Thus Martinez's machine part and numerous elements are likely many times more costly to build than the pure process of claim 24.

4. Speed: Claim 24 is able to do a job faster than Martinez because the claim recites "(e) displaying said pop up digital space to present said dictionary element on said screen when a cursor is placed over said word,". Claim 24 requires the fast step of simply placing a cursor over a word to present its dictionary element. Claim 24 is a benefit because its speed advantage is important in computer innovations. The speed result of claim 24 is different than Martinez. Martinez recites 2 steps in his independent claim 1 to display his similar items, and at least 1 more step such as for replacement. His independent claims 11, 18, and 28 also recite the same steps as independent claim 1.

Claim 1 of Martinez recites "A computer-implemented method of providing access to a database, said method comprising: providing a recursive search process that includes a-d below: a. **responsive** to a cursor's position, identifying a target item; b. searching a database for items similar to said target item; c. providing an indicator, near said target item's position, to show the existence of similar items in said database; and d. **responsive** to a command for access, providing access to said similar items; applying, to a first item in a main application, said recursive search process, **wherein any one of said similar items may become** said target item for said recursive search process; and **responsive** to a command for replacement, replacing said first item with an item from said database."

1

Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.

Although Martinez's at least 2 user action steps do not take a long time, it is significant compared to claim 24. The speed result of claim 24 is demonstrated in working models in which simply placing a cursor over a word is all that is required.

5. Ease of Use: Claim 24 is easier to learn and use than Martinez because the claim recites "(e) displaying said pop up digital space to present said dictionary element on said screen when a cursor is placed over said word,". Claim 24 shows an ease of use because it requires simply placing a cursor over a word to present a dictionary element. This ease of use advantage of claim 24 is especially important for a computer innovation because it enables a computer user to use the computer more facilely, and this counts a great deal.

The ease of use result of claim 24 is different than Martinez because his invention is significantly harder to learn and use. Martinez, for example, requires the learning to use of his numerous parts, steps and functions like the complicated recursive search process, recursive annotation function, and recursive pop-up display function. The numerous elements of Martinez are discussed in the above subheading "1. Omission of Elements:". Thus claim 24 has an ease of use result over Martinez. The ease of use of claim 24 is demonstrated in working models in which simply placing a cursor over a word is all that is required.

6. Ease of Production: Claim 24 per se and it's pure process is easier and cheaper to produce than Martinez. The ease of production of claim 24 is demonstrated in working models made by basic software. In contrast Martinez teaches machine parts called a "computer readable storage medium" from the title of his claims 28 to 37, and a "computer-usable medium". Martinez has numerous parts, steps and functions as discussed in the above subheading "1. Omission of Elements: ". Also Martinez teaches complicated functions like a recursive search process, a recursive annotation function, and a recursive pop-up display function that needs significant programming to produce. Thus the ease of production result of claim 24 is different than the significantly more difficult to produce invention of Martinez.

7. Novelty: Claim 24 has novelty results over Martinez because the claim recites "(d) utilizing a dictionary element for said word on said screen, and (e) displaying said pop up digital space to present said dictionary element on said screen when a cursor is placed over said word,". Merely making a claim different may not appear to be an advantage per se, but it's usually a great advantage. The novelty result of claim 24 is different than Martinez and all previously known

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

counterparts as of the applicant's filing date. Claim 24 and its "pop up digital space to present said dictionary element" is novel over Martinez and his database that is or may be a dictionary. In addition claim 24 and its "dictionary element for said word" is novel over Martinez and his "items similar to the target item". In addition claim 24 and its "dictionary element for said word on said screen" is novel over Martinez and his "items similar to the target item". Thus claim 24 has novelty results over Martinez.

8. Convenience/Mechanization: Claim 24 makes living easier and more convenient because the claim recites "(e) displaying said pop up digital space to present said dictionary element on said screen when a cursor is placed over said word,". Claim 24 is more convenient than Martinez because the claim simply requires the single computerized step of placing a cursor over a word to present the dictionary element.

Instead Martinez's at least 2 user action steps make his invention much less convenient than claim 24. In addition Martinez requires numerous parts, steps and functions that take much more time to use that is not convenient. The numerous element of Martinez are discussed in the above subheading "1. Omission of Elements: ". In addition Martinez teaches complicated functions like a recursive search process, a recursive annotation function, and a recursive pop-up display function that provides complicated mechanization results. Martinez's complicated mechanization results are different than claim 24 and its simple and single mechanization step result. Thus claim 24 provides significant convenience and mechanization results over Martinez.

9. Social Benefit: Claim 24 has greater social benefits than Martinez because the claim provides important educational results. Claim 24 and its "dictionary element for said word" have more educational value than Martinez and his significantly less educational "items similar to the target item". This is because a user of Martinez needs to already understand the not very educational "items similar" in order to use one for replacement. Thus the social benefit result of claim 24 is different than Martinez.

10. Ecology: Claim 24 has great potential to provide ecology benefits because it does not emphasize or require the printing of paper. Paper is from organic matter, in most cases from trees, which are a limited and important natural resource. Claim 24 produces pop up digital spaces to present dictionary elements on a computer screen, and is a pure process. The ecology result of claim 24 is critical and different than Martinez because he teaches the use of printers,

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

the print function, as well as producing machine parts called a "computer readable storage medium" and a "computer-usable medium". Thus the production of machine parts and the print functions of Martinez create significantly more stress on the ecology than the pure process of claim 24.

11. Salability: Claim 24 is easier to sell and market than Martinez because the claim recites "(d) utilizing a dictionary element for said word on said screen, and". The "dictionary element for said word" of claim 24 is common and meets the everyday needs of people. The salability of claim 24 is evident because products and services using the claim are already selling on the market. The companies using claim 24 have been sent infringement notifications, and some have replied in acknowledgement. One acknowledgement reply and the high sales figures from the same company were attached with the Rule 132 declaration that was submitted with Amendment B.

Further claim 24 and it's "dictionary element for said word" has more educational value than Martinez and his significantly less educational "items similar to the target item". This is because a user of Martinez needs to already understand the not very educational "items similar" in order to use one for replacement. Thus the salability result of claim 24 is different than Martinez.

12. Precision: Claim 24 provides greater precision than Martinez. Claim 24 and it's "dictionary element for said word" has significantly more precise information than Martinez's items that are **merely** "similar" to the target item.

13. Market Size: Claim 24 likely has a significantly larger market size than Martinez. Claim 24 and its "dictionary element for said word" has educational value, is common to many people and meets the everyday needs of the market. Instead Martinez teaches his significantly less educational and less useful "items similar to the target item". This because a user of Martinez needs to already understand the not very educational "items similar" in order to use one to replace the target item. In addition products and services using claim 24 are already selling on the market. The companies using claim 24 have been sent infringement notifications, and some have replied in acknowledgement. One acknowledgement reply and the high sales figures from the same company were attached with the Rule 132 declaration that was submitted with Amendment B. Thus the market size result of claim 24 is different than Martinez.

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

14. Potential Competition: Claim 24 recites "(d) utilizing a dictionary element for said word on said screen, and". Claim 24 is demonstrated in working models that were so simple and easy that it took about 2 hours to produce, with standard software and a laptop computer. Claim 24 is so simple and common to the everyday needs of people that, as a result many imitators and copiers are likely to attempt to copy it, and design around it, and try to break the patent as soon as it is brought out. The potential competition result of claim 24 is different than Martinez because his invention has the significantly less useful "items similar to the target item". Martinez is significantly harder to produce with his machine parts called a "computer readable storage medium" and "computer-usable medium" and his complicated functions like the recursive search process, recursive annotation function, and recursive pop-up display function. Thus Martinez is not likely to be imitated or copied by potential competition.

15. Quality: Claim 24 and it's "dictionary element for said word" has significantly higher quality than Martinez and his items that are **merely** "similar" to the target item. Thus claim 24 has a quality result over Martinez.

16. Long Life Cycle: Claim 24 has a potentially long life cycle that can be made and sold for many years because its "dictionary element for said word" is passed from generation to generation. This is an obvious strong advantage. Instead Martinez provides the significantly less useful and less promising "items similar to the target item". Thus the long life cycle result of claim 24 is different than Martinez.

17. Satisfies Existing Need: Claim 24 recites "(e) displaying said pop up digital space to present said dictionary element on said screen when a cursor is placed over said word,". Claim 24 will satisfy an existing, recognized need because it produces "said dictionary element" for a word in a simple, convenient, and unique process. The looking up of dictionary elements for a word, even with prior art computer dictionaries, remains a relatively time consuming, inconvenient, and boring task. Claim 24 and its dictionary element presented in a pop up digital space appear virtually instantaneously when a cursor is placed over a word. Martinez does not satisfy this existing need of claim 24 because he instead provides the significantly slower, less convenient, and not very useful "items similar to the target item". Thus the existing need result of claim 24 is different than Martinez.

1

Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.

18. Development: Claim 24 recites "(e) displaying said pop up digital space to present said dictionary element on said screen when a cursor is placed over said word,". Claim 24 per se is already designed for the market because its lean structure and pure process for providing a dictionary element will not require significant development. The development result of claim 24 is demonstrated in working models that took about 2 hours to produce. The models were developed using standard low cost software, a laptop computer, and a few techniques. The development result of claim 24 is different than Martinez. Martinez requires machine parts called "computer readable storage medium", "computer-usable medium", and complicated functions like a recursive search process, a recursive annotation function, and a recursive pop-up display function, among other numerous elements that needs significant additional programming and appearance work. The numerous elements of Martinez are discussed in the above subheading "1. Omission of Elements: ". Thus Martinez is different than claim 24 because his invention requires significantly more development.

19. Operability: Claim 24 per se and its pure process will work readily as demonstrated by working models made by basic inexpensive software. Products and services using claim 24 are already selling on the market. The companies using claim 24 have been sent infringement notifications, and some have replied in acknowledgement. One acknowledgement reply and the high sales figures from the same company were attached with the Rule 132 declaration that was submitted with Amendment B. The ready operability result of claim 24 is different than Martinez. Martinez teaches machine parts called a "computer readable storage medium", "computer-usable medium", and complicated functions like a recursive search process, a recursive annotation function, and a recursive pop-up display function, among other numerous elements that needs very significant production and programming to be workable. The numerous elements of Martinez are discussed in the above subheading "1. Omission of Elements: ". Thus Martinez likely has a significantly less ready operability result than claim 24.

20. Profitability: Claim 24 likely is easy to sell at a profit or at an acceptable price level because its lean structure and pure process requires no expensive and difficult development tooling or expensive exotic materials to build. Claim 24 is demonstrated in working models made by basic inexpensive software. The profitability result of claim 24 is different than Martinez because he requires expensive tooling to produce his machine parts called "computer

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

readable storage medium", "computer-usable medium" as well as numerous other elements to build that are discussed in the above subheading "1. Omission of Elements: ". Thus Martinez likely has a significantly less profitability result than claim 24.

21. Inertia Need Not Be Overcome: Claim 24 recites "(d) utilizing a dictionary element for said word on said screen, and". Potential manufacturers, users, and sellers of claim 24 will not manifest inertia because products and services using the claim are already selling on the market. The companies using claim 24 have been sent infringement notifications, and some have replied in acknowledgement. One acknowledgement reply and the high sales figures from the same company were attached with the Rule 132 declaration that was submitted with Amendment B. The inertia result of claim 24 is different than Martinez because his "items similar to the target item" is significantly less useful and likely must overcome significant inertia.

22. Minimal Learning Required: People will have to undergo minimal or no learning in order to use claim 24 because the claim recites "(e) displaying said pop up digital space to present said dictionary element on said screen when a cursor is placed over said word,". Simply placing a cursor over a word of claim 24 is a strong advantage because it requires minimal or no learning to get a dictionary element. Instead Martinez requires learning the intricacies of the lookup functions, recursive search process, recursive annotation function, and recursive pop-up display function. In addition Martinez requires numerous other parts, steps and functions that take significant learning to use. The numerous elements of Martinez are discussed in the above subheading "1. Omission of Elements: ". Claim 24 is demonstrated in working models in which simply placing a cursor over a word is all that is required. Thus the minimal or no learning result of claim 24 is different than Martinez.

23. Easy to Promote: Claim 24 recites "(e) displaying said pop up digital space to present said dictionary element on said screen when a cursor is placed over said word,". As of the applicant's filing date, claim 24 solves the omnipresent problem of the slow, time consuming, and often boring task of looking up dictionary elements for a word, even in prior art computer dictionaries. In addition claim 24 per se with its fast, pure process, high visibility, and educational advantages makes it cheap and easy to market, and these are clear advantages. The easy to promote results of claim 24 are different than Martinez. Martinez's "items similar to the target item" is slower, more expensive, and significantly less educational and less useful than claim 24. This is because

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

a user of Martinez needs to already understand the not very educational "items similar" in order
to use one for replacement. Thus Martinez is likely harder to promote than claim 24.

24. Presence of Market: Claim 24 recites "(d) utilizing a dictionary element for said word on
said screen, and". Claim 24 has a market that already exists because computers are ubiquitous
and popular machines and its dictionary element for a word have an everyday usefulness. The
presence of market of claim 24 is evident because products and services using the claim are
already selling on the market. The companies using claim 24 have been sent infringement
notifications, and some have replied in acknowledgement. One acknowledgement reply and the
high sales figures from the same company was attached with the Rule 132 declaration that was
submitted with Amendment B. The presence of market result of claim 24 is different than
Martinez because his "items similar to the target item" is significantly less useful and likely has a
much smaller presence of market.

25. Prototype Availability: Claim 24 has prototypes available and demonstrated in working
models. The prototypes of claim 24 will make it far easier to market since potential purchasers
or licensees will be much more likely to buy something which is real and tangible rather than on
paper only.

26. Broad Patent Coverage Available: Claim 24 likely will have broad patent coverage
available if allowed and this will affect profitability. Since claim 24 is the only source that
performs its certain, unique functions, the claim will be able to charge more than it would in a
competitive situation. Claim 24 performs the unique functions of "(d) utilizing a dictionary
element for said word on said screen, and (e) displaying said pop up digital space to present said
dictionary element on said screen when a cursor is placed over said word,". Martinez does **not**
teach claim 24 anywhere in his invention. Instead Martinez provides the unique and
significantly less useful "items similar to the target item". Thus the likely broad patent coverage
result of claim 24 is different than Martinez.

27. High Sales Anticipated: Claim 24 per se can anticipate a high sales volume because its
lean structure and process for providing a "dictionary element for said word" is very educational,
useful, convenient, cheap to produce, and easy to market. Claim 24 is common and meets the
everyday needs of people. The high sales anticipated result of claim 24 is evident because
products and services using the claim are already selling in high volumes. The companies using

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

claim 24 have been sent infringement notifications, and some have replied in acknowledgement. One acknowledgement reply and the high sales volumes from the same company were attached with the Rule 132 declaration that was submitted with Amendment B. Claim 24 is different than Martinez because his "items similar to the target item" is complex, less convenient, expensive to produce, significantly less educational and less useful, and is therefore harder to market. Thus Martinez likely does not have the high sales anticipated result of claim 24.

28. Youth Market: Young people have substantial discretionary income and tend to spend more in many product areas than the rest of the population, and computers are popular with this age group. Claim 24 likely will appeal to young people because the claim is very useful for young people to learn about a word. Claim 24 provides "a dictionary element for said word" in a simple and convenient manner that helps the learning experience. Claim 24 is important for the purposes of learning and education. Claim 24 is valuable because higher education is often a priority of young people.

Claim 24 will likely command more sales of the youth market than the significantly less educational and less useful "items similar to the target item" of Martinez. This is because a user of Martinez needs to already understand the not very educational "items similar" in order to use one for replacement. Furthermore Martinez does not teach targeting the youth market. Thus the youth market result of claim 24 is different than Martinez.

29. Unexpected Results: The results achieved by claim 24 are new, unexpected, superior, disproportionate, unusual, unsuggested, critical and surprising because its "dictionary element for said word" is presented in a pop up digital space by simply placing a cursor over a word. Claim 24 and its unexpected results did not exist as of the applicant's filing date. Martinez does not teach the unexpected results of claim 24.

30. Crowded Art: Claim 24 is classified in the crowded art of computers, and therefore a small step forward should be regarded as significant. Claim 24 provides the small step forward of presenting a dictionary element in a pop up digital space when a cursor is simply placed over a word. This is a small step forward in the crowded art. Martinez provides the different small step forward of displaying the unique "items similar to the target item" in the crowded art.

31. Unsuggested Modification: Martinez lacks any suggestion that his invention should be modified in a manner required to meet claim 24. Claim 24 recites "(d) utilizing a dictionary

1

Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.

element for said word on said screen, and (e) displaying said pop up digital space to present said dictionary element on said screen when a cursor is placed over said word,". Martinez does **not** teach claim 24 and its "dictionary element for said word". Instead Martinez teaches that a database is or may be a dictionary. In addition Martinez teaches the different and significantly less useful "items similar to the target item". Thus Martinez clearly lacks any suggestion that his invention should be modified in a manner to meet claim 24.

32. Unappreciated Advantage: Martinez and those skilled in the art never appreciated the advantages of claim 24 as of the applicant's filing date, although it is inherent. Claim 24 provides the advantages of presenting a "dictionary element for said word" in a unique process that is fast, convenient and educational. Instead Martinez teaches providing the different and significantly less educational "items similar to the target item". This is because a user of Martinez needs to already understand the not very educational "items similar" in order to use one for replacement. Thus claim 24 has unappreciated advantages not taught by Martinez and the prior art.

33. Poor Reference: Martinez is a poor reference to claim 24. This is because Martinez and his database is or may be a dictionary is vague, foreign and conflicting to claim 24 and it's " (e) displaying said pop up digital space to present said dictionary element on said screen when a cursor is placed over said word,". Further Martinez's "items similar to the target item" are vague, foreign and conflicting to claim 24 and it's "dictionary element for said word". Thus Martinez is a weak reference to claim 24 and should be construed narrowly.

34. Lack of Implementation: Claim 24 recites "(d) utilizing a dictionary element for said word on said screen, and (e) displaying said pop up digital space to present said dictionary element on said screen when a cursor is placed over said word,". Claim 24 provides a "dictionary element for said word" in a process that is fast, convenient and educational. If claim 24 were in fact obvious, because of its advantages, Martinez and those skilled in the art surely would have implemented the claim as of the applicant's filing date. The fact that Martinez and those skilled in the art have not implemented claim 24, despite its great advantages, indicates that it is not obvious.

35. Misunderstood Reference: Martinez does **not** teach what the O.A. relies upon it as supposedly teaching. Martinez teaches that his database is or may be a dictionary, and teaches

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

his "items similar to the target item". Martinez does not teach claim 24 and its different "(d) utilizing a dictionary element for said word on said screen, and". Martinez does not teach claim 24 and its different "(e) displaying said pop up digital space to present said dictionary element on said screen when a cursor is placed over said word,". Thus Martinez is a misunderstood reference of claim 24.

36. Solution of Long-Felt and Unsolved Need: Claim 24 solves a long felt, long existing, but unsolved need. The long existing need claim 24 addresses was not previously solved. Claim 24 presents its "dictionary element for said word" in a unique, fast and convenient process. Claim 24 provides a solution to an educational need that is common and meets the everyday needs of people. Instead Martinez solves the different need of providing the unique and significantly less educational and less useful "items similar to the target item". This is because a user of Martinez needs to already understand the not very educational "items similar" in order to use one for replacement.

37. Contrarian Invention: Claim 24 is contrary to the teachings of Martinez. Claim 24 and it's "(d) utilizing a dictionary element for said word on said screen, and (e) displaying said pop up digital space to present said dictionary element on said screen when a cursor is placed over said word," goes against the grain of what Martinez teaches. Instead Martinez teaches his database is or may be a dictionary that is contrary to claim 24.

Further claim 24 and its educational "dictionary element for said word" goes against the grain of Martinez. Instead Martinez teaches the significantly less educational and less useful "items similar to the target item". This is because a user of Martinez needs to already understand the not very educational "items similar" in order to use one for replacement. Thus claim 24 has contrarian results over Martinez.

38. Strained Interpretation: The O.A. has made a strained interpretation of Martinez that could be made only in hindsight. Martinez clearly does not teach claim 24 and its "(e) displaying said pop up digital space to present said dictionary element on said screen when a cursor is placed over said word,". Instead Martinez teaches that his database is or may be a dictionary. In addition Martinez does not teach claims 24 and its "(d) utilizing a dictionary element for said word on said screen, and". Claim 24 and its "dictionary element for said word" provide an educational result and has an everyday usefulness that is different than Martinez.

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

Martinez teaches the significantly less educational and less useful "items similar to the target item". This is because a user of Martinez needs to already understand the not very educational "items similar" in order to use one for replacement. Thus Martinez is a strained interpretation in regards to claim 24.

39. Solved Different Problem: Claim 24 solves a different problem than Martinez, and such different problem is recited in the claim of: "(d) utilizing a dictionary element for said word on said screen, and (e) displaying said pop up digital space to present said dictionary element on said screen when a cursor is placed over said word,". Claim 24 solves an educational problem by presenting a dictionary element for a word in a fast, simple and convenient manner. Instead Martinez solves the problem of providing the significantly less educational, less useful and different result of "items similar to the target item". This is because a user of Martinez needs to already understand the not very educational "items similar" in order to use one for replacement. Thus Martinez and his replacement operation solve a different problem than claim 24.

40. No Convincing Reasoning: The O.A. has not presented a convincing line of reasoning as to why the subject matter of claim 24 as a whole, including its differences over Martinez, would have been obvious. Martinez clearly does **not** teach the new, unexpected and educational results in claim 24 of "(d) utilizing a dictionary element for said word on said screen, and (e) displaying said pop up digital space to present said dictionary element on said screen when a cursor is placed over said word,". Instead Martinez teaches that his database is or may be a dictionary. In addition Martinez teaches providing the significantly less educational and less useful "items similar to the target item". This is because a user of Martinez needs to already understand the not very educational "items similar" in order to use one for replacement.

From the reasons discussed, the applicant submits that independent claim 24 produces valuable new, unexpected, and different results and hence is unobvious and patentable over Martinez under 35 U.S.C § 103, and requests reconsideration. Accordingly, the applicant submits that independent claim 24 is <u>patentable</u> over Martinez and <u>requests its</u> allowance.

The Rejection of Dependent Claim 25 on Martinez Overcome Under § 102

The O.A. stated, regarding applicant's claim 25, "Martinez et al. show a method...wherein said dictionary elements includes a definition presented in said pop up digital spaces (col. 1, ln 15-30, Fig. 4, item 710, claim 3 - said database is a dictionary),".

1

Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.

Instead previously presented claim 25 recites: "The process of Claim 24 wherein displaying said dictionary element that includes a definition presented in said pop up digital space."

A Review of the Reference of Martinez: Martinez is discussed in the above heading "A Review of the Reference of Martinez:".

The reasons that claim 25 is novel over Martinez include those from referred independent claim 24 as discussed in the above heading of "The Rejection of Independent Claim 24 on Martinez Overcome Under § 102".

Since claim 25 contains no amendments, the reasons under § 102 and § 103 from previous Amendment C are the same, and are reiterated here for the sake of convenience and completeness. Some reasons and text are updated and these are indicated by underlined text. The applicant has corrected the reason containing the typographical error regarding "(...claim 3 - said database is a dictionary)". This updated reason also has the underlined text.

The applicant respectfully disagrees that Martinez describes claim 25 for the following reasons:

1. The O.A. stated "(col. 1, ln 15-30...)" from which Martinez describes, "Examples include U.S. Pat. No. 6,209,006 (**Medl, et al.,** Mar. 27, 2001), which relates to the use of hyperlinks that enable recall of help functions. "Elements of a user interface for an application program are predefined as help functions by the programmer or developer .... Upon selection of a highlighted hyperlinked element, a help window appears providing definitions, functional instructions, etc."

Claim 25 recites "dictionary element that includes a definition presented in said pop up digital space." Claim 25 is novel over Medl et al. (hereinafter Medl) because he does **not** describe a **"dictionary"** and a **"dictionary element"** of the claim anywhere in his invention.

Thus claim 25 recites novel physical features that distinguish over Martinez and his reference of Medl.

2. The O.A. stated "(col. 1, ln 15-30...)" from which Martinez describes, "Another example is U.S. Pat. No. 6,233,571 (**Egger, et al.,** May 15, 2001), which relates to computerized research tools for locating legal opinions, patents and related documents, and how relationships among such documents may be detected and displayed."

Claim 25 recites "dictionary element that includes a definition presented in said pop up digital space."

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

a. Claim 25 is novel over Egger et al. (hereinafter Egger) because he does **not** describe a "**dictionary**" and a "**dictionary element**" of the claim anywhere in his invention.

b. Egger describes "A preferred **definition** of F.sub.N is as follows: where D.sub.N is a damping factor that decreases rapidly as N increases." Claim 25 is novel over Egger because his "definition" is **not** a dictionary element, but instead is an algorithm created by Egger. Thus claim 25 recites novel physical features that distinguish over Martinez and his reference of Egger.

3. The O.A. stated, regarding (col. 1, In 15-30…) in which Martinez describes, "Another example is U.S. Pat. No. 5,649,221 (**Crawford, et al.**, Jul. 15, 1997), which discloses a "reverse electronic dictionary;" the user enters one or more search words which are thought to exist in the definition of the word that is sought."

a. Claim 25 and its "**pop up digital space**" is novel over Crawford et al. (hereinafter Crawford) because he does **not** describe a "**pop up digital space**" anywhere in his invention.

b. Claim 25 and its "**dictionary element**" is novel over Crawford and his "**reverse electronic dictionary**".

c. Claim 25 is novel over Crawford due to MPEP 2131 and its application of § 102 *In re Bond,* 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990), which states:

> The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required.

Crawford does **not** describe a "pop up digital space" of claim 25, and in addition he describes a "**reverse electronic dictionary**". As a result Crawford's invention is **not arranged** as required by claim 25. Claim 25 recites "wherein displaying said dictionary element that includes a definition presented in said pop up digital space." <u>Hence claim 25 recites a new arrangement that is novel over Crawford's arrangement.</u>

Thus claim 25 recites novel physical features that distinguish over Martinez and his reference of Crawford.

4. The O.A. stated, regarding Martinez of "(…Fig. 4…)".

Martinez shows in his (Fig. 4), a "similar items" 430, a "target item" 410 of "print", and "in a pop-up window" 420.

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

Claim 25 and it's "dictionary element that includes **a definition** presented in said pop up digital

space" is novel over Martinez and his "**similar items**". This is because claim 25 and its

definition distinguish over Martinez and his "**items**" that are merely "**similar to the target**

item". Thus claim 25 recites novel physical features that distinguish over Martinez and his Fig.

4.

5. The O.A. stated, regarding Martinez of "(...item 710...)".

Martinez shows in his item 710 the **similar items** of "representation, image, likeness,

resemblance, semblance, similitude, simulacrum, fair copy, faithful copy, certified copy".

Claim 25 and its "dictionary element that includes a **definition** presented in said pop up digital

space" is novel over Martinez and his item 710. This is because the claim and its definition

distinguish over Martinez and his item 710 which show the **merely** similar items.

Thus claim 25 recites novel physical features that distinguish over Martinez and his item 710.

6. The O.A. stated, regarding Martinez of "(...claim 3 - said database is a dictionary)".

Martinez recites in his claim 3: "The computer-implemented method of claim 1, wherein: said

items are words; and said **database is a dictionary.**"

a. Claim 25 and its "dictionary element that includes a **definition** presented in said **pop up**

digital space." is novel over Martinez and his claim 3." This is because Martinez in his claim 3

does **not** recite the "**definition**" or a "**pop up digital space**" of claim 25.

b. Claim 25 is novel over Martinez and his claim 3 due to MPEP 2131 and its application of §

102 *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990), which states:

> The elements must be arranged as required by the claim, but this is not an *ipsissimis*
>
> *verbis* test, i.e., identity of terminology is not required.

Martinez and his claim 3 of "wherein: said items are words; and said **database is a dictionary**"

are **not arranged** as required by claim 25. Claim 25 recites "wherein displaying said **dictionary**

element that includes **a definition** presented in said **pop up digital space**". <u>Hence claim 25</u>

<u>recites a new arrangement that is novel over Martinez's arrangement.</u>

Thus claim 25 recites novel physical features that distinguish over Martinez and his claim 3.

Therefore from the reasons discussed, the applicant submits that claim 25 is novel over

Martinez and <u>requests</u> reconsideration and allowance under 35 U.S.C. § 102.

Dependent Claim 25 Is A Fortiori Patentable Over Martinez

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

<u>Previously presented</u> dependent claim 25 incorporates all the subject matter of independent claim 24 and adds additional subject matter which makes the claim a fortiori and independently patentable over Martinez, or any combination thereof.

Since claim 25 incorporates all the limitations of independent claim 24, claim 25 is patentable for the same reasons given with respect to claim 24. Claim 25 is even more patentable because it adds an additional element.

<u>Previously presented</u> claim 25 recites: "The process of Claim 24 wherein displaying said dictionary element that includes a definition presented in said pop up digital space."

The new and unexpected results that flow from the novel physical features of claim 25 are discussed in the following reasons:

1. **Omission of Elements:** The numerous elements of Martinez that are omitted in claim 25 are: recursive search processes, items similar to the target item, indicator displays a number, showing how many similar items exist, indicator appears as a superscript number superimposed over a small translucent book icon, indicator that includes a function as an icon for sending a command for access or display, the notation "click", the replacement of the target item, on analyzing the context the word "print", for example, has been identified as a noun so similar nouns are listed first among similar items, the mechanism writes data to main application, the "No" branch is taken at decision, a "Yes" branch, lookup functions, lookup function stores a list of similar items, a selected similar item is inserted in place of an original item, inserting a word into text, recursive pop-up display function terminates at block 1390, similar items as images to a target item of an image, and similar items might be components of the same shape as the target item but with various dimensions or made of various materials than the target item, among other elements.

Thus claim 25 is simpler than Martinez without loss of capability. Claim 25 is demonstrated in working models in which the numerous elements of Martinez are omitted.

2. **Novelty:** Claim 25 has novelty results over Martinez because the claim recites "said dictionary element that includes a definition presented in said pop up digital space." Merely making a claim different may not appear to be an advantage per se, but it's usually a great advantage. The novelty results of claim 25 are different than Martinez and all previously known counterparts as of the applicant's filing date. Claim 25 and its "said dictionary element" is novel over Martinez and his database that is or may be a dictionary.

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

In addition Martinez does **not** teach claim 25 and it's "a definition presented in said pop up digital space" anywhere in his invention. Instead Martinez teaches items that are **merely** "similar" to the target item. Further Martinez's reference of Medl does **not** teach a "dictionary element" of claim 25, and does **not** even teach a "dictionary" anywhere in his invention. Thus claim 25 has novelty results over Martinez and Medl.

3. Social Benefit: Claim 25 has greater social benefits than Martinez because the claim provides important educational results. Claim 25 and its "said dictionary element that includes a definition presented in said pop up digital space" has more educational value than Martinez and his significantly less educational "items similar to the target item". This is because a user of Martinez needs to already understand the not very educational "items similar" in order to use one for replacement. Further Martinez's reference of Medl does **not** teach a "dictionary element" of claim 25, and does **not** even teach a "dictionary" anywhere in his invention. Thus the social benefit result of claim 25 is different than Martinez and Medl.

4. Precision: Claim 25 provides greater precision than Martinez. Claim 25 and its "said dictionary element that includes a definition presented in said pop up digital space" has significantly more precise information than Martinez's items that are **merely** "similar" to the target item. Further Martinez's reference of Medl does **not** teach a "dictionary element" of claim 25, and does **not** even teach a "dictionary" anywhere in his invention. Thus the precision result of claim 25 is different than Martinez and Medl.

5. Quality: Claim 25 and it's "said dictionary element that includes a definition" has significantly higher quality than Martinez's items that are **merely** "similar" to the target item. Further Martinez's reference of Medl does **not** teach a "dictionary element" of claim 25, and does **not** even teach a "dictionary" anywhere in his invention. Thus claim 25 has a quality result over Martinez and Medl.

6. Long Life Cycle: Claim 25 has a potentially long life cycle that can be made and sold for many years because it's "said dictionary element that includes a definition" is passed from generation to generation. This is an obvious strong advantage. Instead Martinez provides the significantly less useful and less promising "items similar to the target item". Further Martinez's reference of Medl does **not** teach a "dictionary element" of claim 25, and does **not** even teach a

1

Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.

"dictionary" anywhere in his invention. Thus the long life cycle result of claim 25 is different than Martinez and Medl.

7. **Prototype Availability:** Claim 25 has prototypes available and demonstrated in working models. The prototypes of claim 25 will make it far easier to market since potential purchasers or licensees will be much more likely to buy something which is real and tangible rather than on paper only.

8. **Broad Patent Coverage Available:** Claim 25 likely will have broad patent coverage available if allowed and this will affect profitability. Since claim 25 is the only source that performs its certain, unique functions, the claim will be able to charge more than it would in a competitive situation. Claim 25 performs the unique function of "said dictionary element that includes a definition presented in said pop up digital space." Martinez does **not** teach claim 25 anywhere in his invention. Instead Martinez provides the unique and significantly less useful "items similar to the target item". Further Martinez's reference of Medl does **not** teach a "dictionary element" of claim 25, and does **not** even teach a "dictionary" anywhere in his invention. Thus the likely broad patent coverage result of claim 25 is different than Martinez and his reference of Medl.

9. **Inertia Need Not Be Overcome:** Claim 25 recites "said dictionary element that includes a definition presented in said pop up digital space." Potential manufacturers, users, and sellers of claim 25 will not manifest inertia because products and services using the claim are already selling on the market. The companies using claim 25 have been sent infringement notifications, and some have replied in acknowledgement. One acknowledgement reply and the high sales figures from the same company were attached with the Rule 132 declaration that was submitted with Amendment B. The inertia result of claim 25 is different than Martinez because his "items similar to the target item" is significantly less useful and likely must overcome significant inertia. Further Martinez's reference of Medl does **not** teach a "dictionary element" of claim 25, and does **not** even teach a "dictionary" anywhere in his invention.

10. **Presence of Market:** Claim 25 recites "said dictionary element that includes a definition presented in said pop up digital space." Claim 25 has a market that already exists because computers are ubiquitous and popular machines and it's "a definition" is educational and has an everyday usefulness. The presence of market of claim 25 is evident because products and

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

services using the claim are already selling on the market. The companies using claim 25 have been sent infringement notifications, and some have replied in acknowledgement. One acknowledgement reply and the high sales figures from the same company were attached with the Rule 132 declaration that was submitted with Amendment B. The presence of market result of claim 25 is different than Martinez because his "items similar to the target item" is significantly less educational and less useful, and likely has a much smaller presence of market. This is because a user of Martinez needs to already understand the not very educational "items similar" in order to use one for replacement.   Further Martinez's reference of Medl does **not** teach a "dictionary element" of claim 25, and does **not** even teach a "dictionary" anywhere in his invention.

11. High Sales Anticipated: Claim 25 per se can anticipate a high sales volume because its definition is very educational, useful, convenient, cheap to produce, and easy to market. Claim 25 is common and meets the everyday needs of people. The high sales anticipated of claim 25 is evident because products and services using the claim are already selling in high volumes. The companies using claim 25 have been sent infringement notifications, and some have replied in acknowledgement. One acknowledgement reply and the high sales volumes from the same company were attached with the Rule 132 declaration that was submitted with Amendment B. The high sales result of claim 25 is different than Martinez. Martinez's "items similar to the target item" is expensive to produce, less convenient, significantly less educational and useful, and therefore harder to market. This is because a user of Martinez needs to already understand the not very educational "items similar" in order to use one for replacement.   Further Martinez's reference of Medl does **not** teach a "dictionary element" of claim 25, and does **not** even teach a "dictionary" anywhere in his invention. Thus Martinez and Medl likely do not have the high sales anticipated result of claim 25.

12. Youth Market: Young people have substantial discretionary income and tend to spend more in many product areas than the rest of the population, and computers are popular with this age group. Claim 25 likely will appeal to young people because the claim is very useful for young people to learn about a definition. Claim 25 provides "a definition" in a convenient pop up digital space that helps the learning experience. Claim 25 is important for the purposes of

1

learning and education. Claim 25 is valuable because higher education is often a priority of young people.

Claim 25 will likely command more sales of the youth market than the significantly less educational and useful "items similar to the target item" of Martinez. This is because a user of Martinez needs to already understand the not very educational "items similar" in order to use one for replacement. Furthermore Martinez does not teach targeting the youth market. In addition Martinez's reference of Medl does not teach a "dictionary element" of claim 25, and does not even teach a "dictionary" anywhere in his invention. Thus the youth market result of claim 25 is different than Martinez and Medl.

13. Crowded Art: Claim 25 is classified in the crowded art of computers, and therefore a small step forward should be regarded as significant. Claim 25 provides the small step forward of "said dictionary element that includes a definition presented in said pop up digital space" in the crowded art. Martinez provides the different small step forward of displaying the unique "items similar to the target item" in the crowded art. Further Martinez's reference of Medl does not teach a "dictionary element" of claim 25, and does not even teach a "dictionary" anywhere in his invention. As a result Medl also provides a different small step forward in the crowded art.

14. Unsuggested Modification: Martinez lacks any suggestion that his invention should be modified in a manner required to meet claim 25. Martinez does not teach claim 25 and its "said dictionary element that includes a definition presented in said pop up digital space." Instead Martinez teaches that a database is or may be a dictionary. In addition Martinez teaches the different and significantly less useful "items similar to the target item". Further Martinez's reference of Medl does not teach a "dictionary element" of claim 25, and does not even teach a "dictionary" anywhere in his invention. Thus Martinez and Medl clearly lack any suggestion that their inventions should be modified in a manner to meet claim 25.

15. Poor Reference: Martinez is a poor reference to claim 25. Martinez does not teach "a definition presented in said pop up digital space" of claim 25. Hence Martinez and his "items similar to the target item" are vague, foreign and conflicting to claim 25. Further Martinez's reference of Medl does not teach a "dictionary element" of claim 25, and does not even teach a "dictionary" anywhere in his invention. Thus Martinez and Medl are weak references to claim 25 and should be construed narrowly.

1

Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.

16. Misunderstood Reference: Martinez does **not** teach what the O.A. relies upon it as supposedly teaching. Martinez does **not** teach claim 25 and its "said dictionary element that includes a definition presented in said pop up digital space." Instead Martinez teaches that a database is or may be a dictionary. In addition Martinez teaches the different and significantly less useful "items similar to the target item". Further Martinez's reference of Medl does **not** teach a "dictionary element" of claim 25, and does **not** even teach a "dictionary" anywhere in his invention. Thus Martinez and Medl are misunderstood references of claim 25.

17. Contrarian Invention: Claim 25 is contrary to the teachings of Martinez. Claim 25 and it's "said dictionary element that includes a definition presented in said pop up digital space" goes against the grain of what Martinez teaches. Claim 25 provides an educational result and has an everyday usefulness that is different than Martinez. Instead Martinez teaches the significantly less educational and less useful "items similar to the target item". This is because a user of Martinez needs to already understand the not very educational "items similar" in order to use one for replacement.

In addition Martinez's reference of Medl is contrary to claim 25. Medl does **not** teach a "dictionary element" of claim 25, and does **not** even teach a "dictionary" anywhere in his invention. Thus claim 25 has a contrarian result over Martinez and Medl.

18. Strained Interpretation: The O.A. has made a strained interpretation of Martinez that could be made only in hindsight. Martinez clearly does **not** teach claim 25 and its "said dictionary element that includes a definition presented in said pop up digital space." Instead Martinez teaches that his database is or may be a dictionary. In addition claim 25 and its "a definition" provide an educational result and has an everyday usefulness that is different than Martinez. Martinez teaches the significantly less educational and less useful "items similar to the target item". This is because a user of Martinez needs to already understand the not very educational "items similar" in order to use one for replacement. Further Martinez's reference of Medl does **not** teach a "dictionary element" of claim 25, and does **not** even teach a "dictionary" anywhere in his invention. Thus Martinez and Medl are strained interpretations in regards to claim 24.

19. Solved Different Problem: Claim 25 solves a different problem than Martinez, and such different problem is recited in the claim of "said dictionary element that includes a definition

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

presented in said pop up digital space." Claim 25 solves an educational problem by presenting a

definition in a fast, simple and convenient manner. Instead Martinez solves the different

problem of providing the significantly less educational and less useful "items similar to the target

item". This is because a user of Martinez needs to already understand the not very educational

"items similar" in order to use one for replacement. Thus Martinez and his replacement

operation solve a different problem than claim 25.

In addition Martinez's reference of Medl also solves a different problem than claim 25. This is

because Medl does **not** teach a "dictionary element" of claim 25, and does **not** even teach a

"dictionary" anywhere in his invention. Thus Medl solves different problems than claim 25.

20. No Convincing Reasoning: The O.A. has not presented a convincing line of reasoning as

to why the subject matter of claim 25 as a whole, including its differences over Martinez, would

have been obvious. Martinez clearly does **not** teach the new, unexpected, and educational results

in claim 25 of "said dictionary element that includes a definition presented in said pop up digital

space."

Instead Martinez teaches that his database is or may be a dictionary. In addition Martinez

teaches providing the significantly less educational and less useful "items similar to the target

item". This is because a user of Martinez needs to already understand the not very educational

"items similar" in order to use one for replacement. Further Martinez's reference of Medl does

not teach a "dictionary element" of claim 25, and does **not** even teach a "dictionary" anywhere

in his invention.

From the reasons discussed, the applicant submits that claim 25 produces valuable new,

unexpected, and different results and hence is unobvious and patentable over Martinez under 35

U.S.C § 103, and <u>requests</u> reconsideration. Accordingly the applicant submits that dependent

claim 25 is a fortiori patentable and <u>requests its allowance.</u>

The Rejection of Dependent Claim 27 on Martinez Overcome Under § 102

The O.A. stated, regarding applicant's claim 27, "Martinez et al. show a method...wherein said

pop up digital spaces presents various images that includes digital video when said cursor is

placed over said word or phrase in said text (claim 4 - <u>graphical images</u>),".

Instead currently amended claim 27 recites in clean copy form:

1

Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.

"The process of Claim 24 wherein displaying said pop up digital space presents a video when said cursor is placed over said word."

A Review of the Reference of Martinez: Martinez is discussed in the above heading "A Review of the Reference of Martinez:".

The reasons that claim 27 is novel over Martinez include those from referred independent claim 24 as discussed in the above heading of "The Rejection of Independent Claim 24 on Martinez Overcome Under § 102".

Since claim 27 contains an amendment under § 112, the reason #10 under § 103 from previous Amendment C is updated to reflect the § 112 amendment and is underlined. Other than this, the reasons for claim 27 under § 102 and § 103 from the previous amendment are the same, and are reiterated here for the sake of convenience and completeness. Some reasons and text are updated and these are also indicated by underlined text.

The applicant respectfully disagrees that Martinez describes claim 27 for the following reasons:

1. Claim 27 and it's "**a video**" is novel over claim 4 of Martinez. This is because Martinez does not recite a "**video**" in his claim 4.

Thus claim 27 recites novel physical features that distinguish over Martinez and his claim 4.

2. Claim 27 and it's "**a video**" is novel over claim 4 of Martinez. This is because the singular "a video" distinguishes over Martinez and the plural "non-textual graphical images" from his claim 4.

Thus claim 27 recites novel physical features that distinguish over Martinez and his claim 4.

3. Claim 27 and its "**pop up digital space**" is novel over claim 4 of Martinez. This is because Martinez does not recite a "**pop up digital space**" in his claim 4.

Thus claim 27 recites novel physical features that distinguish over Martinez and his claim 4.

4. Claim 27 recites "said pop up digital space presents a video when said cursor is placed over said word."

The O.A. stated, regarding Martinez of "(claim 4 – graphical images)".

Martinez recites in his (claim 4): "The computer-implemented method of claim 1, wherein said items are non-textual graphical images."

Martinez's claim 4 and its "said items" narrows referred claim 1 and its "items". Referred claim 1 recites, in part, "b. searching a database for **items** similar to said target item;".

1

Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.

Martinez's claim 4 narrows referred claim 1 to essentially read "b. searching a database for **non-textual graphical images** similar to said target item;". Hence narrowed claim 1 and the "**non-textual graphical images**" are now necessarily "similar to said target item", which means "said target item" is now a **non-textual graphical image.**

Martinez does **not** describe claim 27 because his claim 1 is narrowed <u>by its dependent claim 4</u> so that the "items similar" and "said target item" are now **both "non-textual graphical images".** Instead claim 27 has "a video" when a cursor is placed over a "word".

Thus claim 27 recites novel physical features that distinguish over Martinez and his claim 4 and <u>its</u> referred claim 1.

5. Claim 27 is novel over Martinez and his claim 4 and referred claim 1 due to MPEP 2131 and its application of <u>102 *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990),</u> which states:

> The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required.

Martinez and his "target item" and "similar items" that are **both non-textual graphical image(s)** are **not arranged** as required by claim 27. Claim 27 recites "said pop up digital space presents a video when said cursor is placed over said word". <u>Hence claim 27 recites a new arrangement that is novel over Martinez's arrangement.</u>

Thus claim 27 is novel and distinguishes over Martinez.

The Additional Novel Reasons of Claim 27 Over Martinez Under § 102: The applicant submits claim 27 is novel over Martinez for the following additional reasons:

6. Claim 27 and it's "**a video**" is novel over Martinez. This is because Martinez does **not** describe a "**video**" anywhere in his invention.

Thus claim 27 recites novel physical features that distinguish over Martinez.

7. Claim 27 recites "said pop up digital space presents a video when said cursor is placed over said word".

Instead Martinez describes his different images at (col. 7, ln 54-64), "FIG. 14 illustrates one possible user interface display of a graphics application annotated with a pop-up display, according to the teachings of the present invention. This example may represent drawing software, drafting software or some other graphics software displaying images at 1400. The images in this example are triangular shapes that might represent shapes on a map, or structural

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

components, or mechanical components such as fan blades. A first **target item** 1410 has been highlighted. A pop-up display, 1420, **shows similar items,** 1431, 1432, and 1433, and provides access to them."

Martinez shows in his Fig. 14, the target item 1410 which is a triangle, the similar items 1431, 1432, and 1433 which are similar triangles with unidentical dimensions to the target item 1410. Claim 27 and its "presents a video when said cursor is placed over said word" is novel over Martinez. This is because Martinez's **"target item"** and **"similar items"** are **both images.** Claim 27 distinguishes over Martinez since it recites one **"video"** and one **"word"**. Thus claim 27 recites a novel physical feature that distinguishes over Martinez.

Therefore from the reasons discussed, the applicant submits that claim 27 is novel over Martinez and <u>requests</u> reconsideration and allowance under 35 U.S.C. § 102.

Dependent Claim 27 Is A Fortiori Patentable Over Martinez

Currently amended dependent claim 27 incorporates all the subject matter of independent claim 24 and adds additional subject matter which makes the claim a fortiori and independently patentable over Martinez, or any combination thereof.

Since claim 27 incorporates all the limitations of independent claim 24, claim 27 is patentable for the same reasons given with respect to claim 24. Claim 27 is even more patentable because it adds an additional element.

Currently amended claim 27 recites in clean copy form: "The process of Claim 24 wherein displaying said pop up digital space presents a video when said cursor is placed over said word." The new and unexpected results that flow from the novel physical features of claim 27 are discussed in the following reasons:

1. Omission of Elements: The numerous elements of Martinez that are omitted in claim 27 are: recursive search processes, items similar to the target item, indicator displays a number, showing how many similar items exist, indicator appears as a superscript number superimposed over a small translucent book icon, indicator that includes a function as an icon for sending a command for access or display, the notation "click", the replacement of the target item, on analyzing the context the word "print", for example, has been identified as a noun so similar nouns are listed first among similar items, the mechanism writes data to main application, the "No" branch is taken at decision, a "Yes" branch, lookup functions, lookup function stores a list of similar items,

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

a selected similar item is inserted in place of an original item, inserting a word into text,

recursive pop-up display function terminates at block 1390, similar items as images to a target

item of an image, and similar items might be components of the same shape as the target item but

with various dimensions or made of various materials than the target item, among other elements.

Thus claim 27 is simpler than Martinez without loss of capability.

2. Novelty: Claim 27 has a novelty result over Martinez. Merely making a claim different may

not appear to be an advantage per se, but it's usually a great advantage. Martine does not teach

claim 27 and it's "a video" anywhere in his invention. The novelty result of claim 27 is different

than Martinez.

3. Social Benefit: Claim 27 has greater social benefits than Martinez because the claim

provides important educational results. Claim 27 and its "presents a video when said cursor is

placed over said word" can have much more educational value than Martinez. Claim 27 can

present a video, which has extremely high informational content, to learn about a word. In

contrast Martinez provides the significantly less educational and less useful "items similar to the

target item". This is because a user of Martinez needs to already understand the not very

educational "items similar" in order to use one for replacement. Thus the social benefit result of

claim 27 is different than Martinez.

4. Precision: Claim 27 has the opportunity to provide greater precision than Martinez. Claim

27 can present "a video" for a word. The "video" of claim 27 has extremely high informational

content, and this can present significantly more precise information about a word than Martinez's

items that are **merely** "similar" to the target item. Thus the precision result of claim 27 is

different than Martinez.

5. Quality: Claim 27 recites "said pop up digital space presents a video when said cursor is

placed over said word." Claim 27 can provide a video to learn about a word and this has much

more educational quality than Martinez. Instead Martinez provides the significantly less

educational and less useful "items similar to the target item". This is because a user of Martinez

needs to already understand the not very educational "items similar" in order to use one for

replacement. Also claim 27 and it's "a video" has much higher quality and richer information

for a word than Martinez and his "items similar to the target item". This is because Martinez

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

teaches that his "target item" and "items similar" are necessarily both word(s). Thus claim 27 has quality results over Martinez.

6. Operability: Claim 27 per se and its "video" will not require significant technical development and will work readily. The ready operability result of claim 27 is different than Martinez. Martinez teaches machine parts called a "computer readable storage medium", "computer-usable medium", and complicated functions like a recursive search process, a recursive annotation function, and a recursive pop-up display function, among other numerous elements that needs very significant production and programming to be workable. The numerous elements of Martinez are discussed in the above subheading "1. Omission of Elements: ". Thus Martinez likely has a significantly less ready operability result than claim 27.

7. Youth Market: Young people have substantial discretionary income and tend to spend more in many product areas than the rest of the population, and computers are popular with this age group. Claim 27 likely will appeal to young people because the claim recites "presents a video when said cursor is placed over said word". The "video" of claim 27 is very useful to learn about a word for young people. Claim 27 is important for the purposes of learning and education. Claim 27 is valuable because higher education is often a priority of young people. The "video" of claim 27 likely commands more sales than something that is not attractive to young people such as Martinez's invention. The "items similar to the target item" of Martinez is probably boring for most young people. Also a user of Martinez needs to already understand the not very educational "items similar" in order to use one for replacement. As a result his invention is significantly less educational and less useful for young people than claim 27. Furthermore Martinez does not teach targeting the youth market. Thus the youth market result of claim 27 is different than Martinez.

8. Unsuggested Modification: Martinez lacks any suggestion that his invention should be modified in a manner required to meet claim 27. Claim 27 recites "said pop up digital space presents a video when said cursor is placed over said word." Martinez does not teach claim 27 and its "video" and the function of "presents a video when said cursor is placed over said word". Instead Martinez teaches the different and significantly less useful "items similar to the target item" and the alternative in which his "items similar to the target item" are both images. Thus

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

Martinez clearly lacks any suggestion that his invention should be modified in a manner to meet claim 27.

9. Poor Reference: Martinez is a poor reference to claim 27. Martinez does **not** teach "a video" of claim 27. Instead Martinez's "items similar to the target item" are vague, foreign and conflicting to claim 27. Thus Martinez is a weak reference to claim 27 and should be construed narrowly.

10. Misunderstood Reference: Martinez does **not** teach what the O.A. relies upon it as supposedly teaching. The O.A. stated, "Martinez et al. show a method...wherein said pop up digital spaces presents various images that includes digital video when said cursor is placed over said word or phrase in said text (claim 4 – graphical images),". This statement is in regards to claim 13, now canceled, but claim 27 substantially recites the same subject matter. Claim 27 recites "The process of Claim 24 <u>wherein displaying</u> said pop up digital space presents a video when said cursor is placed over said word." Martinez does **not** teach claim 27 and its "**video**" in his claim 4 or anywhere in his invention.

Instead Martinez recites in his (claim 4): "The computer-implemented method of claim 1, wherein said items are **non-textual graphical images.**"

Martinez's claim 4 incorporates all the subject matter of referred claim 1. Claim 1 of Martinez recites, in part, "b. searching a database for **items** similar to said target item;".

Martinez's claim 4 recites "said items" and narrows the "items" of referred claim 1; so that the referred claim essentially recites "b. searching a database for **non-textual graphical images** similar to said target item;". Hence the narrowed claim 1 and the "**non-textual graphical images**" are now necessarily "...similar to said target item", which means "said target item" is now a **non-textual graphical image.**

Martinez does **not** teach claim 27 because his <u>claim 1 is narrowed by dependent claim 4 so that</u> it's "**items similar**" and "**said target item**" are now recited as **both "non-textual graphical images**". Instead claim 27 has "a video" and a "word" because it recites "said pop up digital space presents a video when said cursor is placed over said word." Thus Martinez is a misunderstood reference of claim 27.

11. Contrarian Invention: Claim 27 and its "presents a video when said cursor is placed over said word" go against the grain of what Martinez teaches. Claim 27 is contrary to Martinez

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

because the claim recites a "word and a "video". Instead Martinez teaches the different "items similar to the target item". Thus claim 27 has a contrarian result over Martinez.

12. Strained Interpretation: The O.A. has made a strained interpretation of Martinez that could be made only in hindsight. Martinez does **not** teach the "video" of claim 27 anywhere in his invention. Instead Martinez teaches providing the different "items similar to the target item". Martinez does **not** teach claim 27 because the claim recites one "video" and one "word". Thus Martinez clearly does **not** teach the results in claim 27 of "said pop up digital space presents a video when said cursor is placed over said word".

13. Solved Different Problem: Claim 27 has the opportunity to solve a different problem than Martinez, and such different problem is recited in the claim of "said pop up digital space presents a video when said cursor is placed over said word". Claim 27 can solve an educational problem by presenting a video to learn about a word in a fast, simple and convenient manner. Instead Martinez solves the different problem of providing the significantly less educational and less useful "items similar to the target item". This is because a user of Martinez needs to already understand the not very educational "items similar" in order to use one for replacement. Thus Martinez and his replacement operation solve a different problem than claim 27.

14. No Convincing Reasoning: The O.A. has not presented a convincing line of reasoning as to why the subject matter of claim 27 as a whole, including its differences over Martinez, would have been obvious. Martinez clearly does **not** teach a "video" of claim 27 anywhere in his invention. Hence Martinez clearly does **not** teach the unexpected result in claim 27 of "said pop up digital space presents a video when said cursor is placed over said word". Instead Martinez teaches providing the different "items similar to the target item". Further Martine does **not** teach claim 27 because the claim recites one "video" and one "word" that is different than his "items similar to the target item".

From the reasons discussed, the applicant submits that claim 27 produces valuable new, unexpected, and different results and hence is unobvious and patentable over Martinez under 35 U.S.C § 103, and <u>requests</u> reconsideration. Accordingly the applicant submits that dependent claim 27 is a fortiori patentable and <u>requests its allowance.</u>

The Rejection of Dependent Claim 29 on Martinez Overcome Under § 102

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

The O.A. stated, regarding applicant's claim 29, "Martinez et al. show a method…wherein the dictionary elements that present more than one meaning of said word or phrase, the intended contextual meaning of said word or phrase can be highlighted or otherwise distinguished (Fig. 8, item 810),".

Instead currently amended claim 29 recites in clean copy form: "The process of Claim 24 wherein displaying said dictionary element that presents more than one meaning of said word, the intended contextual meaning of said word is highlighted."

A Review of the Reference of Martinez: Martinez is discussed in the above heading "A Review of the reference of Martinez:".

The reasons that claim 29 is novel over Martinez include those from referred independent claim 24 as discussed in the above heading of "The Rejection of Independent Claim 24 on Martinez Overcome Under § 102".

<u>Since claim 29 contains amendments under § 112, the reasons under § 102 and § 103 from previous Amendment C are updated to reflect the § 112 amendments and are underlined. Other than this, the reasons for claim 29 under § 102 and § 103 from the previous amendment are the same; and are reiterated here for the sake of convenience and completeness. Some reasons and text are updated and these are also indicated by underlined text.</u>

The applicant respectfully disagrees that Martinez describes claim 29 for the following reasons:

1. The O.A. stated, regarding Martinez of "(Fig. 8, item 810)".

Martinez shows at his (Fig. 8) a click 310, the first item of "print" 410, a pop-up window 420, a cursor 520, an exit button 450, and the similar items 710. Martinez shows at his item 810 a "certified copy".

Claim 29 is novel over Martinez because his Fig. 8 and item 810 do **not** show "the **intended contextual meaning** of said word" of claim 29.

Thus claim 29 recites novel physical features that distinguish over Martinez.

2. The O.A. stated, regarding Martinez of "(Fig. 8, item 810)".

Claim 29 is novel over Martinez and his Fig. 8 and item 810 because both do **not** show the **highlighted"** of claim 29.

Therefore claim 29 recites novel physical features that distinguish over Martinez and his (Fig. 8, item 810).

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

The Additional Novel Reasons of Claim 29 Over Martinez Under § 102: The applicant

submits claim 29 is novel over Martinez for the following additional reasons:

Claim 29 recites additional novel reasons that distinguish over Martinez as follows:

3. Martinez describes at (col. 1, In 26-30), "Another example is U.S. Pat. No. 5,649,221

(Crawford, et al., Jul. 15, 1997), which discloses a "reverse electronic dictionary;" the user

enters one or more search words which are thought to exist in the definition of the word that is

sought."

a. Claim 29 and its "<u>displaying</u> said **dictionary element**" is novel over Crawford and his

"**reverse electronic dictionary**".

b. Claim 29 is novel over Crawford due to MPEP 2131 and its application of <u>§ 102 *In re Bond,*</u>

<u>910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990),</u> which states:

> The elements must be arranged as required by the claim, but this is not an *ipsissimis*
>
> *verbis* test, i.e., identity of terminology is not required.

Crawford and his invention of a "**reverse electronic dictionary**" is **not arranged** as required by

claim 29. Claim 29 recites "wherein <u>displaying said **dictionary element** that presents more than</u>

<u>one meaning of said word,</u> the intended contextual meaning of said word is highlighted." <u>Hence</u>

<u>claim 29 recites a new arrangement that is novel over Crawford's arrangement.</u>

Thus claim 29 recites novel physical features that distinguish over Martinez and his reference of

Crawford.

4. Claim 29 and its "one meaning of said word" is novel over Martinez because he does **not**

describe a "**meaning**" of the claim anywhere in his invention.

Thus claim 29 recites novel physical features that distinguish over Martinez.

5. Claim 29 and its "presents **more than one meaning of said word**" is novel over Martinez

because he does **not** describe a "**more than one meaning of said word**" of the claim anywhere

in his invention.

Thus claim 29 recites novel physical features that distinguish over Martinez.

6. Claim 29 recites "the intended contextual meaning of said word".

Claim 29 is novel over Martinez because he does **not** describe the "**intended contextual**

meaning of said word" of the claim anywhere in his invention.

Thus claim 29 recites novel physical features that distinguish over Martinez.

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

7. Claim 29 recites "wherein <u>displaying said dictionary element that presents more than one</u>
<u>meaning of said word</u>, the intended contextual meaning of said word is highlighted."
Martinez describes a "highlighted" 3 times.

a. The first is Martinez's reference of Medl at (col. 1, ln 14-22), "Many approaches have been
proposed to retrieving information and displaying it to a computer user. Examples include U.S.
Pat. No. 6,209,006 (Medl, et al., Mar. 27, 2001), which relates to the use of hyperlinks that
enable recall of help functions. "Elements of a user interface for an application program are
predefined as help functions by the programmer or developer . . . . Upon selection of a
highlighted hyperlinked element, a help window appears providing definitions, functional
instructions, etc."

Claim 29 is novel over Martinez's reference of Medl because the "hyperlinked element" of Medl
is highlighted before "providing definitions, functional instructions, etc." Instead claim 29 and
its "the intended contextual meaning" **is highlighted after** "said dictionary element <u>that</u> presents
more than one meaning".

b. The second is Martinez at (col. 4, ln 49-53), "The target item is **highlighted**, 410. A pop-up
display, 420, shows similar items, 430, and provides access to said similar items 430."

c. The third is Martinez at (col. 7, ln 61-64), "A first target item 1410 has been **highlighted**. A
pop-up display, 1420, shows similar items, 1431, 1432, and 1433, and provides access to them."

Claim 29 is novel over the last two descriptions of Martinez because his "target item" and "first
target item" **are highlighted before** showing the "similar items". Instead claim 29 and its "the
intended contextual meaning" **is highlighted after** "said dictionary element <u>that</u> presents more
than one meaning".

Thus claim 29 recites novel physical features that distinguish over Martinez.

8. Martinez describes a "highlighted" 3 times as discussed in the previous reason.
Claim 29 is novel over Martinez and his "highlighted" due to MPEP 2131 and its application of
§ 102 <u>In re Bond</u>, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990), which states:

> The elements must be arranged as required by the claim, but this is not an *ipsissimis*
> *verbis* test, i.e., identity of terminology is not required.

Martinez and the "hyperlinked element", "target item", and "first target item" that are
highlighted before showing the "items similar" are **not arranged** as required by claim 29.

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

Claim 29 recites "said dictionary element <u>that presents more than one meaning of said word,</u> the intended contextual meaning of said word is highlighted." <u>Hence claim 29 recites a new arrangement that is novel over Martinez's arrangement.</u>

Thus claim 29 recites novel physical features that distinguish over Martinez.

9. Claim 29 recites "wherein <u>displaying said dictionary element that presents more than one meaning of said word,</u> the intended contextual meaning of said word is highlighted."

Martinez describes at (col. 4, In 26-29), "The invention searches a database for **items similar to the target item**, and provides an indicator, 230, near word 210's position, to show the existence of similar items in said database."

Claim 29 and its "**more than one meaning of said word, the intended contextual meaning of said word**" is novel over Martinez and his "**items**" that are merely "**similar to the target item**".

Thus claim 29 recites novel physical features that distinguish over Martinez.

10. Claim 29 recites "the intended contextual meaning of said word is highlighted."

Martinez describes at (col. 4, In 26-29), "The invention searches a database for **items similar to the target item**, and provides an indicator, 230, near word 210's position, to show the existence of similar items in said database."

Claim 29 and its "**intended contextual meaning of said word**" is novel over Martinez and his "**items similar to said target item**". This is because claim 29 and its "**intended contextual meaning**" is a **direct** meaning for a word that distinguishes over Martinez and his "**items**" that are merely "**similar to the target item**".

Thus claim 29 recites novel physical features that distinguish over Martinez.

Therefore from the reasons discussed, the applicant submits that claim 29 is novel over Martinez and <u>requests</u> reconsideration and allowance under 35 U.S.C. § 102.

Dependent Claim 29 Is A Fortiori Patentable Over Martinez

Currently amended dependent claim 29 incorporates all the subject matter of independent claim 24 and adds additional subject matter which makes the claim a fortiori and independently patentable over Martinez, or any combination thereof.

Since claim 29 incorporates all the limitations of independent claim 24, claim 29 is patentable for the same reasons given with respect to claim 24. Claim 29 is even more patentable because it adds additional elements.

1

Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.

Currently amended claim 29 recites in clean copy form: "The process of Claim 24 wherein displaying said dictionary element that presents more than one meaning of said word, the intended contextual meaning of said word is highlighted."

The new and unexpected results that flow from the novel physical features of claim 29 are discussed in the following reasons:

1. Omission of Elements: The numerous elements of Martinez that are omitted in claim 29 are: recursive search processes, items similar to the target item, indicator displays a number, showing how many similar items exist, indicator appears as a superscript number superimposed over a small translucent book icon, indicator that includes a function as an icon for sending a command for access or display, the notation "click", the replacement of the target item, on analyzing the context the word "print", for example, has been identified as a noun so similar nouns are listed first among similar items, the mechanism writes data to main application, the "No" branch is taken at decision, a "Yes" branch, lookup functions, lookup function stores a list of similar items, a selected similar item is inserted in place of an original item, inserting a word into text, recursive pop-up display function terminates at block 1390, similar items as images to a target item of an image, and similar items might be components of the same shape as the target item but with various dimensions or made of various materials than the target item, among other elements. Thus claim 29 is simpler than Martinez without loss of capability. Claim 29 is demonstrated in working models in which the numerous elements of Martinez are omitted.

2. Ease of Use: Claim 29 is easier to learn and use than Martinez because the claim recites "wherein displaying said dictionary element that presents more than one meaning of said word, the intended contextual meaning of said word is highlighted." Claim 29 requires no action or learning because the intended contextual meaning of a word is already highlighted for a user. This ease of use advantage is especially important in computer innovations because the claim enables people to use the computer more facilely, and this counts a great deal.

Martinez does not teach the ease of use of claim 29 anywhere in his invention. Instead Martinez recites 2 steps in his independent claim 1 to display his similar items, and at least 1 more step such as for replacement. His independent claims 11, 18, and 28 also recite the same steps as independent claim 1.

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

Claim 1 of Martinez recites "A computer-implemented method of providing access to a database, said method comprising: providing a recursive search process that includes a-d below: a. **responsive** to a cursor's position, identifying a target item; b. searching a database for items similar to said target item; c. providing an indicator, near said target item's position, to show the existence of similar items in said database; and d. **responsive** to a command for access, providing access to said similar items; applying, to a first item in a main application, said recursive search process, **wherein any one of said similar items may become** said target item for said recursive search process; and **responsive** to a command for replacement, replacing said first item with an item from said database."

Although Martinez's at least 2 user action steps do not take a long time, it is significant compared to claim 29. Thus claim 29 has an ease of use result over Martinez. Claim 29 is demonstrated in working models in which the intended contextual meaning is already highlighted.

3. **Novelty:** Claim 29 has novelty results over Martinez because the claim recites "wherein displaying said dictionary element that presents more than one meaning of said word, the intended contextual meaning of said word is highlighted." Merely making a claim different may not appear to be an advantage per se, but it's usually a great advantage. Martinez does not teach claim 29 and its "more than one meaning", "the intended contextual meaning", "the intended contextual meaning is highlighted", or a "meaning" anywhere in his invention. Hence the novelty result of claim 29 is different than Martinez and all previously known counterparts as of the applicant's filing date. Thus claim 29 has novelty results over Martinez.

4. **Convenience/Mechanization:** Claim 29 makes living easier and more convenient because it already highlights the intended contextual meaning of a word in a pop up digital space, and this is an advantage. Claim 29 computerizes the manual task of using techniques such as using a pencil to write the correct meaning of a word on paper. Martinez does not teach the mechanization advantage of claim 29. In addition Martinez requires numerous parts, steps and functions that take much more time to use which is not convenient. The numerous element of Martinez are discussed in the above subheading "1. Omission of Elements:". Thus the convenience and mechanization result of claim 29 is different than Martinez.

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

5. Social Benefit: Claim 29 has greater social benefits than Martinez because the claim provides important educational results. Claim 29 provides certainty by highlighting the intended contextual meaning of a word, and this facilitates the learning experience. Claim 29 prevents people from having to guess the intended meaning of a word when more than one meaning are presented. Martinez does **not** teach this social benefit of claim 29. Thus the social benefit result of claim 29 is different than Martinez.

6. Salability: Claim 29 likely is easier to sell and market than Martinez. Claim 29 and its "the intended contextual meaning of said word is highlighted" is very helpful and educational. These advantages of claim 29 are common and meet the everyday needs of people. Instead Martinez teaches the significantly less educational and less useful "items similar to the target item". This is because a user of Martinez needs to already understand the not very educational "items similar" in order to use one for replacement. Thus the salability result of claim 29 is different than Martinez.

7. Potential Competition: Claim 29 is potentially very popular because of its "the intended contextual meaning of said word is highlighted". The pure process of claim 29 is so simple, educational, and easy to produce that many imitators and copiers are likely to attempt to copy it or design around it, or try to break the claim as soon as it is brought out. Martinez does **not** teach claim 29 and its "the intended contextual meaning of said word is highlighted" anywhere in his invention. Instead Martinez teaches the significantly less educational and less useful "items similar to the target item". This is because a user of Martinez needs to already understand the not very educational "items similar" in order to use one for replacement. Thus the potential competition result of claim 29 is different than Martinez.

8. Quality: Claim 29 produces a higher quality output than Martinez. Claim 29 provides richer information from its "said dictionary element <u>that</u> presents more than one meaning of said word". Also claim 29 provides the quality result of "the intended contextual meaning of said word is highlighted." Martinez does **not** teach these high quality outputs of claim 29. Instead Martinez teaches the significantly lower quality result of items that are **merely** "similar" to the target item. Thus claim 29 has quality results over Martinez.

9. New Use: Claim 29 has discovered a new use for the highlight function that did not exist as of the applicant's filing date. The highlight function is newly used in claim 29 to indicate the

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

intended contextual meaning of a word. Martinez does **not** teach this new use of claim 29 anywhere in his invention. Thus claim 29 has a new use result over Martinez.

10. Long Life Cycle: Claim 29 has a potentially long life cycle that can be made and sold for many years because its educational "dictionary element <u>that</u> presents more than one meaning of said word" is passed from generation to generation. Also the claim's new result of "the intended contextual meaning of said word is highlighted" is very useful and has a timeless quality. These are obvious strong advantages. Martinez does **not** teach these advantages of claim 29. Instead Martinez provides the significantly less educational and less promising "items similar to the target item". This is because a user of Martinez needs to already understand the not very educational "items similar" in order to use one for replacement. Thus the long life cycle result of claim 29 is different than Martinez.

11. Minimal Learning Required: Claim 29 requires minimal or no learning to use because its intended contextual meaning of a word is already highlighted. Martinez does **not** teach this result of claim 29. Instead Martinez teaches requiring at least 2 user action steps to show his "items similar to the target item" and many other steps and functions to learn his invention. Although Martinez do not require significant learning, but they are very significant compared to the minimal or no learning of claim 29. Thus the minimal or no learning result of claim 29 is different than Martinez.

12. Combination Product: Claim 29 and its separate functions of "presents more than one meaning of said word" and "the intended contextual meaning of said word is highlighted" produces a combination product that grooves well together. The combination of claim 29 did not exist as of the applicant's filing date. Martinez does **not** teach this combination product result of claim 29. Thus the combination product result of claim 29 is different than Martinez.

13. Prototype Availability: Claim 29 has a prototype available and demonstrated in working models. The prototype of claim 29 will make it far easier to market since potential purchasers or licensees will be much more likely to buy something which is real and tangible rather than on paper only.

14. Visibility of Invention in Final Product: Claim 29 and its "the intended contextual meaning of said word is highlighted" presents a bright contrast that is highly visible. The high visibility will be a distinct marketing advantage for claim 29. Martinez does **not** teach the

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

specific visibility result of claim 29. Thus the high visibility result of claim 29 is different than Martinez.

15. Youth Market: Young people have substantial discretionary income and tend to spend more in many product areas than the rest of the population, and computers are popular with this age group. Claim 29 likely will appeal to young people because the claim is very useful for young people to learn about a word. Claim 29 and its "intended contextual meaning of said word is highlighted" helps the learning experience. Claim 29 is important for the purposes of learning and education. Claim 29 is valuable because higher education is often a priority of young people.

Claim 29 will likely command more sales of the youth market than Martinez and his significantly less educational and less useful "items similar to the target item". This is because a user of Martinez needs to already understand the not very educational "items similar" in order to use one for replacement. Furthermore Martinez does not teach targeting the youth market. Thus the youth market result of claim 29 is different than Martinez.

16. Unexpected Results: The results achieved by claim 29 are new, unexpected, superior, disproportionate, unusual, unsuggested; critical, surprising and did not exist as of the applicant's filing date. Claim 29 provides the unexpected results of "<u>displaying said dictionary element that presents more than one meaning of said word,</u> the intended contextual meaning of said word is highlighted". Martinez does not teach these unexpected results of claim 29.

17. Unappreciated Advantage: As of the applicant's filing date Martinez and those skilled in the art never appreciated the advantages of claim 29 as of the applicant's filing date although it is inherent. Claim 29 provides the advantage of "the intended contextual meaning of said word is highlighted". Martinez does not teach this advantage of claim 29. Thus claim 29 has an unappreciated advantage not taught by Martinez and the prior art.

18. Poor Reference: Martinez is a poor reference to claim 29. Martinez does not teach a "meaning" and "the intended contextual meaning of said word is highlighted" of claim 29. Hence Martinez and his "items similar to the target item" are vague, foreign and conflicting to claim 29. Thus Martinez is a weak reference to claim 29 and should be construed narrowly.

19. Lack of Implementation: If claim 29 were in fact obvious, because of its advantages, Martinez and those skilled in the art surely would have implemented it by the applicant's filing

1

Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.

date. The fact that Martinez and those skilled in the art have not implemented claim 29, despite

its great advantages, indicates that it is not obvious. Claim 29 provides the advantages of

"wherein displaying said dictionary element that presents more than one meaning of said word,

the intended contextual meaning of said word is highlighted".

20. Contrarian Invention: Claim 29 is contrary to the teachings of Martinez. Martinez does

not teach a "meaning" of claim 29. In addition claim 29 goes against the grain of Martinez

because he does **not** teach the claim and it's "the intended contextual meaning of said word is

highlighted". Hence claim 29 has educational benefits. Instead Martinez teaches the

significantly less educational "items similar to the target item". This is because a user of

Martinez needs to already understand the not very educational "items similar" in order to use one

for replacement. Thus claim 29 has a contrarian invention result over Martinez.

21. Solved Different Problem: Claim 29 solves a different problem than Martinez, and such

different problem is recited in the claim of "the intended contextual meaning of said word is

highlighted." Claim 29 solves an educational problem. Instead Martinez provides the

significantly less educational and less useful "items similar to the target item". This is because a

user of Martinez needs to already understand the not very educational "items similar" in order to

use one for replacement. Thus Martinez and his replacement operation solve a different problem

than claim 29.

22. No Convincing Reasoning: The O.A. has not presented a convincing line of reasoning as

to why the subject matter of claim 29 as a whole, including its differences over Martinez, would

have been obvious. Martinez clearly does **not** teach the new, unexpected results in claim 29 of

"wherein displaying said dictionary element that presents more than one meaning of said word,

the intended contextual meaning of said word is highlighted."

From the reasons discussed, the applicant submits that claim 29 produces valuable new,

unexpected, and different results and hence is unobvious and patentable over Martinez under 35

U.S.C § 103, and requests reconsideration. Accordingly the applicant submits that dependent

claim 29 is a fortiori patentable and requests its allowance.

The Rejection of Dependent Claim 32 on Martinez Overcome Under § 102

The O.A. stated, regarding applicant's claim 32, "Martinez et al. show a method... wherein said

dictionary elements are to be used judiciously (Fig. 5),".

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

Instead currently amended claim 32 recites in clean copy form: "The process of Claim 24 wherein displaying said dictionary element that is presented with respect to an intended audience."

A Review of the Reference of Martinez: Martinez is discussed in the above heading "A Review of the Reference of Martinez:".

The reasons that claim 32 is novel over Martinez include those from referred independent claim 24 as discussed in the above heading of "The Rejection of Independent Claim 24 on Martinez Overcome Under § 102".

<u>Since claim 32 contains amendments under § 112, the reasons under § 102 and § 103 from previous Amendment C are updated to reflect the § 112 amendments and are underlined. Other than this, the reasons for claim 32 under § 102 and § 103 from the previous amendment are the same, and are reiterated here for the sake of convenience and completeness. Some reasons and text are updated and these are also indicated by underlined text.</u>

The applicant respectfully disagrees that Martinez describes claim 32 for the following reasons:

1. The O.A. stated, regarding Martinez of "(Fig. 5)".

Martinez shows at his Fig. 5, an indicator 230, a "in a pop-up window" 420, the "similar items" of "copy, indentation, mark, picture, photograph, engraving, letter, type, edition, in print, fix, impress, publish, engrave, stamp" 430, the item "copy" 510, and a cursor 520.

Claim 32 is novel over Martinez because he does **not** describe the claim and its "dictionary element <u>that</u> is presented **with respect to an intended audience**" in his Fig. 5.

Thus claim 32 recites novel physical features that distinguish over Martinez and his Fig. 5.

The Additional Novel Reason of Claim 32 Over Martinez Under § 102: The applicant submits claim 32 is novel over Martinez for the following additional reasons:

2. Claim 32 is novel over Martinez because he does **not** describe the claim and its "dictionary element <u>that</u> is presented **with respect to an intended audience**" anywhere in his invention. In fact Martinez does **not** describe an "audience" anywhere in his invention.

Thus claim 32 recites novel physical features that distinguish over Martinez.

3. Martinez describes at (col. 1, ln 26-30), "Another example is U.S. Pat. No. 5,649,221 (Crawford, et al., Jul. 15, 1997), which discloses a "reverse electronic dictionary;" the user

1

Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.

enters one or more search words which are thought to exist in the definition of the word that is sought."

a. Claim 32 and its "**dictionary element**" is novel over Crawford and his "**reverse electronic dictionary**".

b. Claim 32 is novel over Crawford due to MPEP 2131 and its application of § 102 *In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)*, which states:

> The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required.

Crawford and his invention of a "**reverse electronic dictionary**" is **not arranged** as required by claim 32. Claim 32 recites "wherein <u>displaying said **dictionary element** that</u> is presented with respect to an intended audience." <u>Hence claim 32 recites a new arrangement that is novel over Crawford's arrangement.</u>

Thus claim 32 recites novel physical features that distinguish over Martinez and his reference of Crawford.

Therefore from the reasons discussed, the applicant submits that claim 32 is novel over Martinez and <u>requests</u> reconsideration and allowance under 35 U.S.C. § 102.

Dependent Claim 32 Is A Fortiori Patentable Over Martinez

Currently amended dependent claim 32 incorporates all the subject matter of independent claim 24 and adds additional subject matter which makes the claim a fortiori and independently patentable over Martinez, or any combination thereof.

Since claim 32 incorporates all the limitations of independent claim 24, claim 32 is patentable for the same reasons given with respect to claim 24. Claim 32 is even more patentable because it adds additional elements.

Currently amended claim 32 recites in clean copy form: "The process of Claim 24 wherein displaying said dictionary element that is presented with respect to an intended audience."

The new and unexpected results that flow from the novel physical features of claim 32 are discussed in the following reasons:

1. Omission of Elements: The numerous elements of Martinez that are omitted in claim 32 are: recursive search processes, items similar to the target item, indicator displays a number, showing how many similar items exist, indicator appears as a superscript number superimposed over a

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

small translucent book icon, indicator that includes a function as an icon for sending a command

for access or display, the notation "click", the replacement of the target item, on analyzing the

context the word "print", for example, has been identified as a noun so similar nouns are listed

first among similar items, the mechanism writes data to main application, the "No" branch is

taken at decision, a "Yes" branch, lookup functions, lookup function stores a list of similar items,

a selected similar item is inserted in place of an original item, inserting a word into text,

recursive pop-up display function terminates at block 1390, similar items as images to a target

item of an image, and similar items might be components of the same shape as the target item but

with various dimensions or made of various materials than the target item, among other elements.

Thus claim 32 is simpler than Martinez without loss of capability. Claim 32 is demonstrated in

working models in which the numerous elements of Martinez are omitted.

2. Obviation of a Specific Disadvantage of an Existing Invention: Martinez teaches the

uniform and homogeneous "items similar to the target item" that is provided regardless of any

audience, and this is a specific disadvantage of his invention. Claim 32 obviates this specific

disadvantage of Martinez because the claim provides "said dictionary element <u>that</u> is presented

with respect to an intended audience." Claim 32 can present its dictionary element in many

varied ways and levels of difficulty according to the many types of intended audiences. Martinez

does not teach claim 32 and it's "presented with respect to an intended audience". In fact

Martinez does not teach an "audience" at all. Thus claim 32 obviates a specific disadvantage of

Martinez.

3. Novelty: Claim 32 has a novelty result over Martinez. Merely making a claim different may

not appear to be an advantage per se, but it's usually a great advantage. The novelty results of

claim 32 are different than Martinez and all previously known counterparts as of the applicant's

filing date. Martinez does **not** teach claim 32 and its "said dictionary element <u>that</u> is presented

with respect to an intended audience" anywhere in his invention. In fact Martinez does **not** teach

an "audience" at all. Thus claim 32 has a novelty result over Martinez.

4. Social Benefit: Claim 32 has greater social benefits than Martinez because the claim

provides important educational results. Claim 32 provides an educational benefit because its

dictionary element "is presented with respect to an intended audience" and this enhances the

learning experience. Martinez does **not** teach claim 32 and its "said dictionary element <u>that</u> is

1

Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.

presented with respect to an intended audience". In fact Martinez does not teach an "audience" at all. Thus the social benefit result of claim 32 is different than Martinez.

5. Quality: Claim 32 produces a higher quality output than Martinez. Claim 32 provides "said dictionary element that is presented with respect to an intended audience." Claim 32 provides an educational result because it presents a dictionary element that is appropriate to an intended audience, and this enhances the learning experience. In addition the dictionary element of claim 32 is presented in varied ways and levels of difficulty based on the many types of intended audiences. These are high quality results of 32. Martinez does not teach claim 32 and its "said dictionary element that is presented with respect to an intended audience". In fact Martinez does not teach an "audience" at all. Thus claim 32 has quality results over Martinez.

6. Inferior Performance: Claim 32 can provide an inferior performance benefit because the claim provides "said dictionary element that is presented with respect to an intended audience." The "dictionary element" of claim 32 may perform worse than other dictionary material available, and this can be a great advantage.

For example the "dictionary element" of claim 32 can be presented at a basic level that is appropriate, for example, to an intended audience of young children. This inferior performance provides the advantages of making a dictionary element more understandable and a more effective learning experience for the young children audience. This is an inferior result compared to the dictionary material for an adult audience.

Another example is the "dictionary element" of claim 32 can be presented in large text formats that are appropriate, for example, to an intended audience with eyesight impairments. This is an inferior result that takes up more space than regular size text. The inferior performance provides the advantage of making the large text "dictionary element" more viewable and more readable for an intended audience with eyesight impairments.

Another example is the "dictionary element" of claim 32 can be presented in acronyms and abbreviations that are appropriate to an intended audience of electrical engineers. The acronyms and abbreviations are inferior results to complete words. The inferior performance provides the advantages of making such acronyms and abbreviations more readable and enables faster reading for the intended electrical engineer audience.

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

Martinez does **not** teach claim 32 and its "said dictionary element <u>that</u> is presented with respect to an intended audience". In fact Martinez does **not** teach an "audience" at all. Thus claim 32 has an inferior performance advantage over Martinez.

7. Long Life Cycle: Claim 32 has a potentially long life cycle that can be made and sold for many years because its "said dictionary element" is passed from generation to generation. Also the claim's new result of "said dictionary element <u>that</u> is presented with respect to an intended audience" is very useful and has a timeless quality. These are obvious strong advantages. Instead Martinez provides the significantly less useful and less promising "items similar to the target item". Thus the long life cycle result of claim 32 is different than Martinez.

8. Prototype Availability: Claim 32 has prototypes available and demonstrated in working models. The prototypes of claim 32 will make it far easier to market since potential purchasers or licensees will be much more likely to buy something which is real and tangible rather than on paper only.

9. Broad Patent Coverage Available: Claim 32 likely will have broad patent coverage available if allowed and this will affect profitability. Since claim 32 is the only source that performs its certain, unique functions, the claim will be able to charge more than it would in a competitive situation. Claim 32 performs the unique function of "said dictionary element <u>that</u> is presented with respect to an intended audience." Martinez does **not** teach claim 32 and it's "presented with respect to an intended audience". In fact Martinez does **not** teach an "audience" at all. Instead Martinez provides the unique and significantly less useful "items similar to the target item". Thus the likely broad coverage result of claim 32 is different than Martinez.

10. Youth Market: Young people have substantial discretionary income and tend to spend more in many product areas than the rest of the population, and computers are popular with this age group. Claim 32 likely will appeal to young people because the claim provides "dictionary element <u>that</u> is presented with respect to an intended audience". Claim 32 is useful for the intended audience of young people. This is because a dictionary element presented with respect to this audience enhances their learning experience. Claim 32 is important for the purposes of learning and education. Claim 32 is valuable because higher education is often a priority of young people.

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

Claim 32 will likely command more sales of the youth market than the significantly less educational and less useful "items similar to the target item" of Martinez. This is because a user of Martinez needs to already understand the not very educational "items similar" in order to use one for replacement. Furthermore Martinez does **not** teach targeting the youth market. Thus the youth market result of claim 32 is different than Martinez.

11. Unexpected Results: The results achieved by claim 32 are new, unexpected, superior, disproportionate, unusual, unsuggested, critical and surprising because of its "said dictionary element <u>that</u> is presented with respect to an intended audience". Martinez does **not** teach the unexpected results of claim 32.

12. Crowded Art: Claim 32 is classified in the crowded art of computers, and therefore a small step forward should be regarded as significant. Claim 32 provides the small step forward of "said dictionary element <u>that</u> is presented with respect to an intended audience" in the crowded art. Martinez provides the different small step forward of displaying the unique "items similar to the target item" in the crowded art.

13. Unsuggested Modification: Martinez lacks any suggestion that his invention should be modified in a manner required to meet claim 32. Claim 32 recites "wherein <u>displaying said dictionary element that</u> is presented with respect to an intended audience." Martinez does **not** teach claim 32 and it's "presented with respect to an intended audience". In fact Martinez does **not** teach an "audience" at all. Thus Martinez clearly lacks any suggestion that his invention should be modified in a manner to meet claim 32.

14. Poor Reference: Martinez is a poor reference to claim 32. Claim 32 recites "<u>displaying said dictionary element that</u> is presented with respect to an intended audience." Martinez is entirely foreign to claim 32 because he does **not** teach the "presented with respect to an intended audience" of the claim anywhere in his invention. In fact Martinez does **not** teach an "audience" at all. In addition Martinez and his "database is a dictionary" is conflicting to "said dictionary element" of claim 32. Thus Martinez is a weak reference to claim 32 and should be construed narrowly.

15. Misunderstood Reference: Martinez does **not** teach what the O.A. relies upon it as supposedly teaching. The O.A. stated regarding claim 32, "Martinez et al. show a method... wherein said dictionary elements are to be used judiciously (Fig. 5),". Martinez shows at his Fig.

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

5, an indicator 230, a "in a pop-up window" 420, the "similar items" of "copy, indentation, mark, picture, photograph, engraving, letter, type, edition, in print, fix, impress, publish, engrave, stamp" 430, the item "copy" 510, and a cursor 520.

Martinez, in his Fig. 5, does not teach claim 32 and its "dictionary element <u>that</u> is presented with respect to an intended audience". Further Martinez does not teach claim 32 anywhere in his invention. In fact Martinez does not teach an "audience" at all. Thus Martinez is a misunderstood reference of claim 32.

16. Contrarian Invention: Claim 32 is contrary to the teachings of Martinez. Claim 32 and its "said dictionary element <u>that</u> is presented with respect to an intended audience" goes against the grain of what Martinez teaches. Martinez teaches a uniform and homogeneous "items similar to the target item" regardless of any audience. This is because Martinez does not teach claim 32 and it's "presented with respect to an intended audience". In fact Martinez does not teach an "audience" at all. Thus claim 32 is a contrarian invention to Martinez.

17. Strained Interpretation: The O.A. has made a strained interpretation of Martinez that could be made only in hindsight. This is because Martinez clearly does not teach claim 32 and it's "dictionary element <u>that</u> is presented with respect to an intended audience". In fact Martinez does not teach an "audience" at all.

18. New Principle of Operation: Claim 32 utilizes a new principle of operation. Claim 32 utilizes a new principle of operation because it recites "said dictionary element <u>that</u> is presented with respect to an intended audience." The new principle of operation of claim 32 is not taught by Martinez and the prior art as of the applicant's filing date. The applicant has blazed a trail, rather than followed one.

19. No Convincing Reasoning: The O.A. has not presented a convincing line of reasoning as to why the subject matter of claim 32 as a whole, including its differences over Martinez, would have been obvious. Martinez clearly does not teach the new, unexpected results in claim 32 of "said dictionary element <u>that</u> is presented with respect to an intended audience". In fact Martinez does not teach an "audience" at all.

From the reasons discussed, the applicant submits that claim 32 produces valuable new, unexpected, and different results and hence is unobvious and patentable over Martinez under 35

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

U.S.C § 103, and <u>requests</u> reconsideration. Accordingly the applicant submits that dependent

claim 32 is a fortiori patentable and <u>requests its allowance</u>.

The Rejection of Dependent Claim 35 on Martinez Overcome Under § 102

The O.A. stated, regarding applicant's claim 35, "Claims…35 are rejected under 35 U.S.C.

102(e) as being anticipated by Martinez et al. (7,519,576)."

Previously presented claim 35 recites: "The process of Claim 24 wherein presenting a language

used in said pop up digital space that is different from the language of said word."

A Review of the Reference of Martinez: Martinez is discussed in the above heading "A

Review of the Reference of Martinez:".

The reasons that claim 35 is novel over Martinez include those from referred independent claim

24 as discussed in the above heading of "The Rejection of Independent Claim 24 on Martinez

Overcome Under § 102".

The applicant respectfully disagrees that Martinez describes claim 35 for the following reasons:

1. The O.A. stated that claim 35 is "anticipated by Martinez".

Claim 35 recites: "The process of Claim 24 wherein presenting a language used in said pop up

digital space that is different from the language of said word."

Martinez does **not** describe claim 35 and its "a language" anywhere in his invention, and hence

does not anticipate claim 35.

Thus claim 35 recites novel physical features that distinguish over Martinez.

2. The O.A. stated that claim 35 is "anticipated by Martinez".

Claim 35 recites: "The process of Claim 24 wherein presenting a language used in said pop up

digital space that is different from the language of said word."

Martinez does **not** describe claim 35 and its "a language used in said pop up digital space that is

different from the language of said word" anywhere in his invention, and hence does not

anticipate claim 35.

Thus claim 35 recites novel physical features that distinguish over Martinez.

Therefore from the reasons discussed, the applicant submits that claim 35 is novel over

Martinez and requests reconsideration and allowance under 35 U.S.C. § 102.

Dependent Claim 35 is Rejected on Martinez and Abir Under 35 U.S.C. 103

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

The O.A. stated at #5 "The following is a quotation of 35 U.S.C. 103(a) which forms the basis

for all obviousness rejections set forth in this Office action:

      (a) A patent may not be obtained though the invention is not identically disclosed or

      described as set forth in section 102 of this title, if the differences between the subject

      matter sought to patented and the prior art are such that the subject matter as a whole

      would have been obvious at the time the invention was made to a person having ordinary

      skill in the art to which said subject matter pertains. Patentability shall not be negatived by

      the manner in which the invention was made."

The O.A. further stated at #6 "Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable

over Martinez et al (cited above) in view of Abir (6,692,170).

      In regard to claim 35, Martinez et al. show the method discussed above. They do not

specifically show that a language used in said pop up digital spaces can be different from the

language used in said text or be a multitude of languages. Abir shows that a language translator

feature could be added to an electronic dictionary (claims 13-15, col. 8). Therefore, it would be

obvious to one of ordinary skill in the art at the time of the invention to add these features

because they make the system more user-friendly."

<u>The applicant respectfully disagrees that "In regard to claim 35, Martinez et al. show the method</u>

<u>discussed above." Instead previously presented claim 35 recites: "The process of Claim 24</u>

<u>wherein presenting a language used in said pop up digital space that is different from the</u>

<u>language of said word."</u>

<u>In addition the</u> applicant respectfully disagrees that "Martinez et al. show the method discussed

above" due to the § 102 and § 103 reasons from claims 24,25,27,29,32, and 35 that are discussed

in the above headings.

<u>In addition the O.A. does not clearly communicate the combination findings for rejecting claim</u>

<u>35 under § 103. The O.A. suggested the combination of "Abir shows that a language translator</u>

<u>feature could be added to an electronic dictionary (claims 13-15, col. 8)". The applicant</u>

<u>respectfully points out that Abir does **not** teach "a language translator" and "an electronic</u>

<u>dictionary" in his claims 13-15 and at his col. 8, or anywhere in his invention. Hence Martinez</u>

<u>and Abir do not support the combination findings. Since the O.A. is unclear whether the</u>

1

Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.

"electronic dictionary" is from Martinez or Abir, it will be presumed to come from Martinez since his description is the closest. Martinez describes that his database may be a dictionary.

A Review of the Reference of Martinez:

Martinez is discussed in the above heading "A Review of the Reference of Martinez:".

A Review of the Reference of Abir:

Abir teaches an invention for inputting a desired character, word or phrase from numerous related entries into a text on a computer display for word processing. Abir's preferred embodiment has a partition area to display an onscreen keyboard. The virtual keyboard may operate to include words in other foreign languages, characters, and characters used in foreign languages.

The user selects one or more first characters of the desired character, word, or phrase on the keyboard. This prompts another window to show a set list with very large groups of characters, words or phrases from those selected first characters. The user may use a cursor to point and enlarge the characters, words or phrases on the set list. The user chooses the character, word, word string, or phrase to insert in the text.

Dependent Claim 35 Is A Fortiori Patentable Over the Combination of Martinez and Abir

Previously presented dependent claim 35 incorporates all the subject matter of independent claim 24 and adds additional subject matter which makes the claim a fortiori and independently patentable over Martinez and Abir, or any combination thereof.

Since previously presented claim 35 incorporates all the limitations of independent claim 24, claim 35 is patentable for the same reasons given with respect to claim 24. Claim 35 is even more patentable because it adds additional elements.

Previously presented claim 35 recites: "The process of Claim 24 wherein presenting a language used in said pop up digital space that is different from the language of said word."

Since claim 35 contains no amendments, the reasons under § 102 and § 103 from previous Amendment C are the same, and are reiterated here for the sake of convenience and completeness. Some reasons and text are updated and these are indicated by underlined text.

The applicant respectfully disagrees that claim 35 is unpatentable due to the combination of Martinez and Abir.

The applicant respectfully requests reconsideration of this rejection, for the following reasons:

1

Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.

1. Intended functions destroyed.

2. Unsuggested combination.

3. References are individually complete.

4. References take different approaches.

5. References teach away.

6. Impossible to combine.

7. Inoperative combination.

8. Modifications necessary.

9. Claimed features lacking.

10. Synergism.

11. Multiplicity of steps required.

12. Claim 35 produces new and unexpected results and hence is unobvious and patentable over Martinez and Abir under § 103.

1. Intended Functions Destroyed

Martinez and Abir are not legally combinable to meet claim 35 since doing so will destroy their intended functions.

Martinez teaches in his abstract "The invention provides a convenient mechanism to thoroughly search a database for useful items."

Martinez teaches at (col. 2, In 35-38), "To give a more detailed example, one might employ the invention by applying a recursive annotation function to items in a main application, as follows: responsive to a cursor's position, identifying **a target item**; searching a database for **items similar to said target item**; providing an indicator, near the target item's position, to show that **similar items** from said database may be displayed; and providing, near the target item's position, an icon for sending a command for display to a recursive pop-up display function. The pop-up display function displays the similar items in a pop-up window, near the target item's position. Any one of the similar items in the pop-up window may become a target item for the above-mentioned recursive annotation function. A user may select a **similar item** from the database **for use** in the main application."

Abir teaches at (col. 1, In 12-13), "This invention relates to method and apparatus for inputting text for word processing and other communications."

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

Since claim 35 recites "wherein presenting a language used in said pop up digital space that is different from the language of said word", this will destroy the intended functions in Martinez and Abir.

The combination to meet claim 35 would show **Martinez's** "similar items" in a language to replace a target item that uses the different language in the main application. Hence Martinez now shows the replacement similar item that is in a different language from the main application. This produces a nonsensical text and destroys Martinez's intended function of providing "useful items" for use in the main application.

The combination to meet claim 35 would show **Abir's** inputted text that uses a different language from the language used in the "word processing and other communications". This produces a nonsensical word processing and communications and destroys Abir's intended function of "inputting text for word processing and other communications".

Therefore the intended functions of Martinez and Abir are destroyed if combined to meet claim 35.

2. Unsuggested Combination

<u>The O.A., regarding the combination of Martinez and Abir, stated "Abir shows that a language translator feature could be added to an electronic dictionary (claims 13-15, col. 8)."</u>
<u>Abir does **not** teach "a language translator" and "an electronic dictionary" in his claims 13-15 and at his col. 8, or anywhere in his invention. In addition a "dictionary" is not needed to teach claim 35.</u>
<u>The references of Martinez and Abir do not contain any suggestion (express or implied), motivation, or teaching that they be combined in the manner suggested to meet claim 35.</u>
Claim 35 recites "wherein presenting a language used in said pop up digital space that is different from the language of said word."

Martinez does **not** teach a "language" anywhere in his invention. Both **Martinez** and **Abir** do **not** teach claim 35 and it's "a language used in said pop up digital space that is **different** from the language of said word" anywhere in their inventions.

<u>With regard to the proposed combination of Martinez and Abir, it is well known that in order for any prior art references themselves to be validly combined for use in a prior-art § 103 rejection,</u>

1

Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.

the references themselves (or some other prior art) must suggest that they be combined. E.g., as was stated in In re Sernaker, 217 U.S.P.Q. 1, 6 (C.A.F.C. 1983):

> "[P]rior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantages to be derived from combining their teachings."

That the suggestion to combine the references should not come from applicant was forcefully stated in Orthopedic Equipment Co. v. United States, 217 U.S.P.Q. 193, 199 (C.A.F.C. 1983):

> "It is wrong to use the patent in suit [here the patent application] as a guide through the maze of prior art references, combining the right references in the right way to achieve the result of the claims in suit [here the claims pending]. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law [here the PTO]."

As was further stated in Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 U.S.P.Q.2d 1434 (C.A.F.C. 1988):

> "[w]here prior-art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself ... *Something in the prior art must suggest the desirability and thus the obviousness of making the combination.*" [Emphasis supplied.]

In line with these decisions, the Board stated in Ex parte Levengood, 28 U.S.P.Q.2d 1300 (P.T.O.B.A.&I. 1993):

> "In order to establish a prima facie case of obviousness, it is necessary for the examiner to present evidence, preferably in the form of some teaching, suggestion, incentive or inference in the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in the art would have been led to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention. ... That which is within the capabilities of one skilled in the art is not synonymous with obviousness . ... That one can reconstruct and/or explain the theoretical mechanism of an invention by means of logic and sound scientific impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention.... Our reviewing courts have often advised the Patent and

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

Trademark Office that it can satisfy the burden of establishing a prima facie case of
obviousness only by showing some objective teaching in either the prior art, or
knowledge generally available 'to combine the relevant teachings of the references.' ...
Accordingly, an examiner cannot establish obviousness by locating references which
describe various aspects of a patent applicant's invention without also providing evidence
of the motivating force which would impel one skilled in the art to do what the patent
applicant has done."

There is no reason given in the O.A. to support the proposed combination, other than the
statement "Therefore, it would be obvious to one of ordinary skill in the art at the time of the
invention to add these features because they make the system more user-friendly."

Abir does **not** teach "these features" of "a language translator" and "an electronic dictionary" as
the O.A. stated, in his claims 13-15 and at his col. 8, or anywhere in his invention. In addition
"an electronic dictionary" is not needed to teach claim 35.

The fact that both references teach a dictionary is not sufficient to gratuitously and selectively
substitute parts of one reference for a part of another reference in order to attempt to meet
applicant's novel claimed combination, despite the fact that claim 35 does not recite a
"dictionary".

The O.A. stated that the combination of Martinez and Abir produces an advantage "because they
make the system more user-friendly." The applicant submits the fact that the supposed
combination produces such an advantage, even though claim 35 has other different advantages,
militates in favor of the applicant. Even if the references could be combined it proves that the
supposed combination produces a new and unexpected result and hence is unobvious.

The applicant therefore submits that combining Martinez and Abir is not legally justified and is
therefore improper. Thus applicant submits that the rejection of claim 35 on these references is
also improper and should be withdrawn.

The applicant respectfully request, if claim 35 is again rejected upon any combination of
references, that the Examiner include an explanation, in accordance with M.P.E.P. § 706.02. Ex
parte Clapp, 27 U.S.P.Q. 972 (P.O.B.A. 1985), and Ex parte Levengood, supra, a "factual basis
to support his conclusion that would have been obvious" to make the combination.

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

<u>Therefore the combination of Martinez and Abir to meet claim 35 in the manner that the O.A.</u>
<u>has done is unsuggested.</u>

3. References are Individually Complete

Each reference is complete and functional in itself, so there would be no reason to use parts from
or add or substitute parts to any reference to meet claim 35.

Martinez teaches a "recursive search process", "pop-up window", the "items similar to a target
item", and to search a database for useful items to replace a target item in a main application.

Abir teaches a "partition area", a "virtual keyboard", functions for locating "the appropriate
character", and to find the desired character, word or phrase to input in word processing or other
communications.

Both **Martinez** and **Abir** do not teach claim 35 and its "wherein presenting a language used in
said pop up digital space that **is different** from the language of said word" anywhere in their
inventions.

The combination to meet claim 35 would show **Martinez's** "similar items" in a language to
replace a target item that uses the different language in the main application. Hence Martinez
now shows the replacement similar item that is in a different language from the main application.
This produces a nonsensical text in the main application.

The combination to meet claim 35 would show **Abir's** inputted text that uses a different
language from the language used in the "word processing and other communications". This
produces a nonsensical word processing and communications.

Therefore the references of Martinez and Abir are individually complete and there is no reason to
modify them to meet claim 35 since it would produce nonsensical results.

4. References Take Different Approaches

Martinez and Abir take mutually exclusive paths and reach different solutions to a similar
problem. Since they teach away from each other, it would not be logical to combine them to
meet claim 35 under MPEP 2142.

Martinez and **Abir** solve a similar problem. **Martinez** solves the problem of providing "useful
items" for use in his main application by replacing a target item with a similar item. **Abir** solves
the similar problem of inserting a desired character, word or phrase in word processing or other
communications.

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

Martinez takes a different approach than Abir by using a "recursive search process", "pop-up window", and the "items similar to a target item".

Abir takes a different approach than Martinez by using a "partition area", a "virtual keyboard", and functions for locating "the appropriate character". Abir does **not** teach the "pop-up window" of Martinez.

The combination to meet claim 35 would show **Martinez's** "similar items" in a language to replace a target item that uses the different language in the main application. Hence Martinez now shows the replacement similar item that is in a different language from the main application. This produces a nonsensical text in the main application.

The combination to meet claim 35 would show **Abir's** inputted text that uses a different language from the language used in the "word processing and other communications". This produces a nonsensical word processing and communications.

Therefore since Martinez and Abir teach away from each other, it would not be logical to combine them to meet claim 35 because it would produce nonsensical results.

5. References Teach Away

Martinez and Abir themselves teach away, expressly or by implication, from the suggested combination to meet claim 35.

The O.A. regarding the combination of Martinez and Abir, stated "Abir shows that a language translator feature could be added to an electronic dictionary (claims 13-15, col. 8). Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention to add these features because they make the system more user-friendly."

<u>Abir does **not** teach "a language translator" and "an electronic dictionary" in his claims 13-15 and at his col. 8, or anywhere in his invention. In addition a "dictionary" is not needed to teach claim 35.</u>

Instead **Abir** teaches a "partition area", a "virtual keyboard", functions for locating "the appropriate character", and to find the desired character, word or phrase to input in word processing or other communications.

Martinez does **not** teach a "language" of claim 35 anywhere in his invention. Instead **Martinez** teaches a "recursive search process", "pop-up window", the "items similar to a target item", and to search a database for useful items to replace a target item in a main application.

1

Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.

In addition the combination to meet claim 35 would show **Martinez's** "similar items" in a language to replace a target item that uses the different language in the main application. Hence Martinez now shows the replacement similar item that is in a different language from the main application. This produces a nonsensical text in the main application.

In addition the combination to meet claim 35 would show **Abir's** inputted text that uses a different language from the language used in the "word processing and other communications". This produces a nonsensical word processing and communications that does not "make the system more user-friendly".

Therefore Martinez and Abir themselves teach away from the suggested combination to meet claim 35 because the combination would produce nonsensical results.

6. Impossible to Combine

Those skilled in the art would find it physically impossible to combine Martinez and Abir to meet claim 35.

Both **Martinez** and **Abir** do not teach claim 35 and its "wherein presenting a language used in said pop up digital space that is **different** from the language of said word" anywhere in their inventions.

The combination to meet claim 35 would show **Martinez's** "similar items" in a language to replace a target item that uses the different language in the main application. Hence Martinez now shows the replacement similar item that is in a different language from the main application. This produces a nonsensical text in the main application.

The combination to meet claim 35 would show **Abir's** inputted text that uses a different language from the language used in the "word processing and other communications". This produces a nonsensical word processing and communications.

Further for the combination to make sense, this would require all the characters, words, phrases, and text to be replaced in the main application, word processing, or other communications. All the replacements need to use the different language of Martinez's replacement similar item, and the different language of Abir's inputted text.

This is a physically impossible task since all the replacements to a different language in the main application, word processing, or other communications are required based on one replacement similar item of Martinez, and one inputted text of Abir.

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

<u>Therefore it is impossible to combine Martinez and Abir to meet claim 35.</u>

7. Inoperative Combination

If Martinez and Abir could be combined to meet claim 35, the references would produce an inoperative combination.

<u>Both **Martinez** and **Abir** do **not** teach claim 35 and its "wherein presenting a language used in said pop up digital space that **is different** from the language of said word" anywhere in their inventions.</u>

The combination to meet claim 35 would show **Martinez's** "similar items" in a language to replace a target item that uses the different language in the main application. Hence Martinez now shows the replacement similar item that is in a different language from the main application. This produces a nonsensical text in the main application.

The combination to meet claim 35 would show **Abir's** inputted text that uses a different language from the language used in the "word processing and other communications". This produces a nonsensical word processing and communications.

Therefore the combination of Martinez and Abir to meet claim 35 produces an inoperative combination because of the nonsensical results.

8. Modifications Necessary

<u>It would be necessary to make modifications, not taught in Martinez and Abir, in order to combine the references in the manner suggested to meet claim 35.</u>

The O.A., regarding the suggested combination of Martinez and Abir, stated "Abir shows that a language translator feature could be added to an electronic dictionary (claims 13-15, col. 8)."
<u>Abir does **not** teach "a language translator" and "an electronic dictionary" in his claims 13-15 and his col. 8, or anywhere in his invention.</u>

<u>As a result **Abir** needs to be modified by adding "a language translator" feature and "an electronic dictionary" feature, despite the fact that a "dictionary" is not needed to teach claim 35.</u>
In addition both **Martinez** and **Abir**, to meet claim 35, need to be modified by adding the features in the claim of "presenting a language used in said pop up digital space that **is different** from the language of said word."
This modification would show **Martinez's** "similar items" in a language to replace a target item that uses the different language in the main application. Hence Martinez now shows the

1

Lee DeGross　　Appn. Number 10/081,579　　Exam. Group/Art Unit 2626　　Amnt. 116 contd.

replacement similar item that is in a different language from the main application. This produces a nonsensical text in the main application.

This modification would show **Abir's** inputted text that uses a different language from the language used in the "word processing and other communications". This produces a nonsensical word processing and communications.

Since the modifications produce nonsensical results, Martinez needs to eliminate his replacement function. Likewise Abir needs to eliminate his "text input" function.

In addition Martinez needs to eliminate his intended function of providing "useful items" for use in the main application. Likewise Abir needs to eliminate his intended function of "inputting text for word processing and other communications".

Therefore modifications are necessary, not taught in Martinez and Abir, in order to combine the references in the manner suggested to meet claim 35.

9. Claimed Features Lacking

Even if combined, Martinez and Abir would not meet all of the features of claim 35. Claim 35 recites: "The process of Claim 24 wherein presenting a language used in said pop up digital space that is different from the language of said word."

The combination of **Martinez** and **Abir** does not teach or suggest all the claim limitations of claim 35. This is because the combination lacks the features in claim 35 of "presenting a language used in said pop up digital space that is **different** from the language of said word."

Therefore the features of claim 35 are lacking in the combination of Martinez and Abir.

10. Synergism

The whole of the result achieved by the process of claim 35 is greater than the sum of the respective results of the individual references of Martinez and Abir.

Claim 35 recites "The process of Claim 24 wherein presenting a language used in said pop up digital space that is different from the language of said word." Claim 35 achieves an educational result because a person learns about a word in a different language.

Both **Martinez** and **Abir** do not teach claim 35 and its educational result of learning about a word in a different language. This is because Martinez and Abir do not teach claim 35 and it's "a language used in said pop up digital space that is **different** from the language of said word" anywhere in their inventions.

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

Instead **Martinez** teaches replacing a target item with a similar item in the main application.
Instead **Abir** teaches inputting a desired or appropriate character, word or phrase in word
processing and other communications.

Therefore the educational result achieved by claim 35 of learning about a word in a different
language is greater than the sum of the respective results of the individual references of Martinez
and Abir.

11. Multiplicity of Steps Required

The combination <u>of Martinez and Abir</u> to meet claim 35 requires a series of separate, awkward
combinative steps that are too involved to be considered obvious.

<u>The combination of **Martinez and Abir** needs to be modified by adding the features in claim 35</u>
<u>of</u> "presenting a language used in said pop up digital space that **is different** from the language of
said word."

This combinative step would show **Martinez's** "similar items" in a language to replace a target
item that uses the different language in the main application. Hence Martinez now shows the
replacement similar item that is in a different language from the main application. This produces
a nonsensical text in the main application.

This combinative step would show **Abir's** inputted text that uses a different language from the
language used in the "word processing and other communications". This produces a nonsensical
word processing and communications.

<u>These combinative steps to meet claim 35 produces nonsensical results. As a result for the</u>
<u>combination to make sense, Martinez needs to eliminate his replacement function and Abir needs</u>
<u>to eliminate his "text input" function.</u>

<u>Furthermore</u> for the combination to make sense, Martinez needs to eliminate his intended
function of providing "useful items" for use in the main application. <u>Likewise</u> Abir needs to
eliminate his intended function of "inputting text for word processing and other
communications".

Therefore the combination of Martinez and Abir to meet claim 35 requires a multiplicity of
<u>separate, awkward</u> steps that are too involved to be considered obvious.

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

A Prima Facie Case and Claim 35: The applicant submits that the rejection of claim 35 on Martinez and Abir does not set forth a prima facie case of obviousness, as required by MPEP 2142. This section requires that:

1. There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine their teachings to meet claim 35.

2. There must be a reasonable expectation of success.

3. The prior art references when combined must teach or suggest all the claim limitations.

Claim 35 recites "The process of Claim 24 wherein presenting a language used in said pop up digital space that is different from the language of said word."

The applicant submits that the rejection does not meet Requirement 1 because neither Martinez nor Abir suggests such a combination, and one skilled in the art would have no reason to make such a combination to meet claim 35 because it produces nonsensical results as follows:

The combination to meet claim 35 would show Martinez's "similar items" in a language to replace a target item that uses the different language in the main application. Hence Martinez now shows the replacement similar item that is in a different language from the main application. This produces a nonsensical text in the main application.

The combination to meet claim 35 would show Abir's inputted text that uses a different language from the language used in the "word processing and other communications". This produces a nonsensical word processing and communications.

Further Martinez and Abir are not directed to solving the same problem as claim 35 because the claim solves the problem of learning about a word in a different language. Martinez solves the different problem of providing "useful items" for use in his main application by replacing a target item with a similar item. Abir solves the different problem of providing a "method and apparatus for inputting text for word processing and other communications."

Moreover, the applicant submits that the rejection does not meet Requirement 2. Martinez and Abir are not combinable because their intended functions would be destroyed if one attempted to combine them to meet claim 35 as follows:

The combination would show Martinez's "similar items" in a language to replace a target item that uses the different language in the main application. Hence Martinez now shows the

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

replacement similar item that is in a different language from the main application. This produces a nonsensical text and destroys Martinez's intended function of providing "useful items" for use in the main application.

The combination would show **Abir's** inputted text that uses a different language from the language used in the "word processing and other communications". This produces a nonsensical word processing and communications and destroys Abir's intended function of "inputting text for word processing and other communications".

Since the combination to meet claim 35 produces nonsensical results and destroys the intended functions of Martinez and Abir, there is no reasonable expectation of success.

Finally the applicant submits that the rejection does not meet Requirement 3 because, even if the combination could be legally made, the combination does not show <u>all the features in claim 35 of</u> "The process of Claim 24 wherein presenting a language used in said pop up digital space that is different from the language of said word."

The applicant submits these distinctions are patentable under § 103 because of the reasons discussed in the next heading of "12. Claim <u>35 Produces New and Unexpected Results and Hence is Unobvious and Patentable Over Martinez and Abir Under § 103</u>".

12. <u>Claim 35 Produces New and Unexpected Results and Hence is Unobvious and Patentable Over Martinez and Abir Under § 103</u>

<u>The applicant submits that claim 35 is also unobvious and hence patentable under § 103 since it produces new and unexpected results over Martinez and Abir, or any combination thereof.</u>
<u>Previously presented claim 35 recites: "The process of Claim 24 wherein presenting a language used in said pop up digital space that is different from the language of said word."</u>
<u>The O.A. suggested the combination of "Abir shows that a language translator feature could be added to an electronic dictionary". As mentioned since the O.A. is unclear whether the "electronic dictionary" is from Martinez or Abir, it will be presumed to come from Martinez since his description is the closest. Martinez describes that his database may be a dictionary.</u>
The new and unexpected results that flow from claim 35 are discussed in the following reasons:
1. Miscellaneous: The applicant respectfully disagrees with the O.A. statement that "In regard to <u>claim 35,</u> Martinez et al. show the method discussed above." The reasons are discussed above under the headings <u>for claims 24,25,27,29,32, and 35.</u>

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

2. Omission of Elements: Numerous elements from the combination of Martinez and Abir are omitted in claim 35. Claim 35 recites: "The process of Claim 24 wherein presenting a language used in said pop up digital space that is different from the language of said word."
The omitted elements of **Martinez** are: recursive search processes, items similar to the target item, indicator displays a number, showing how many similar items exist, indicator appears as a superscript number superimposed over a small translucent book icon, indicator that includes a function as an icon for sending a command for access or display, the notation "click", the replacement of the target item, on analyzing the context the word "print", for example, has been identified as a noun so similar nouns are listed first among similar items, the mechanism writes data to main application, the "No" branch is taken at decision, a "Yes" branch, lookup functions, lookup function stores a list of similar items, a selected similar item is inserted in place of an original item, inserting a word into text, recursive pop-up display function terminates at block 1390, and similar items, for example, might be components of the same shape, with various dimensions or made of various materials than the target item, among other elements.
The omitted elements of **Abir** are: a partition area set within the display means for delineating the appropriate character keyset, words which appear are magnified according to a user-defined resolution, in a predetermined area, the predetermined area of the keyboard, on the display area the words themselves will be far too small to be legible, an insert box, the arrangement and numbers of rows and columns and other specifics and considerations of the keyboard screen layout and visual design are user-defined, a whole word set, predesignated list of words, a word/phrase set list, manually designating the set list closed, set lists, a set list screen, a set list window will include words arranged in an alphabetical manner, words will be set in the keyboard in a particular manner, usually in a logical order with words beginning with first character in the language or other defined text to be input at one position, and words beginning with the last character in the language or other defined text to be input at an opposite position, 60,000 words on the board, in a magnified resolution the user may have ten words each in a viewable font, and a user will be able to remove words that they never use, among other elements.
Thus claim 35 is simpler than the combination of Martinez and Abir without loss of capability. Claim 35 is demonstrated in working models in which the numerous elements of Martinez <u>and</u> <u>Abir</u> are omitted.

1

Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.

3. Cost: Claim 35 per se is likely to be cheaper to build than the combination of Martinez and Abir because the claim is a pure process. Martinez and Abir have numerous parts, steps and functions as discussed in the previous subheading "2. Omission of Elements: ". Also Martinez teaches machine parts of a "computer readable storage medium" and a "computer-usable medium". Likewise Abir teaches a machine part of "apparatus for inputting text". The combination of Martinez and Abir with its machine parts and numerous elements are many times more costly to build than claim 35 which is a pure process. Thus the low cost result of claim 35 is different than the combination of Martinez and Abir.

4. Ease of Production: Claim 35 per se, which is a pure process, is likely easier and cheaper to produce than the combination of Martinez and Abir. Martinez teaches machine parts called a "computer readable storage medium" and a "computer-usable medium". Likewise Abir teaches a machine part of "apparatus for inputting text". The combination of Martinez and Abir needs significant resources to produce its machine parts and numerous elements as discussed in the above subheading "2. Omission of Elements: ". Thus the ease of production result of claim 35 is different than the significantly more difficult to produce combination of Martinez and Abir.

5. Novelty: Claim 35 recites "wherein presenting a language used in said pop up digital space that is different from the language of said word."

Both Martinez and Abir do not teach claim 35 and its "a language used in said pop up digital space that **is different** from the language of said word". As a result the combination of Martinez and Abir does **not** teach the 2 different languages as recited in claim 35.

The O.A. suggested the combination of "Abir shows that a language translator feature could be added to an electronic dictionary". Abir does not teach "a language translator" anywhere in his invention. The combination does not need a "dictionary" in order to teach claim 35.

Merely making a claim different may not appear to be an advantage per se, but it's usually a great advantage. The novelty results of claim 35 are different than the combination of Martinez and Abir and all previously known counterparts as of the applicant's filing date.

Thus claim 35 has novelty results over Martinez, Abir, their combination, and their suggested combination.

6. Social Benefit: Claim 35 has greater social benefits than Martinez because the claim provides important educational results. Claim 35 recites "presenting a language used in said pop

1

Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.

up digital space that is different from the language of said word". Claim 35 provides a fast, convenient and educational process for a person to learn about a word in a different language. The combination of Martinez and Abir to meet claim 35 provides no educational benefits. This is because the combination would show **Martinez's** "similar items" in a language to replace a target item that uses the different language in the main application. Hence Martinez now shows the replacement similar item that is in a different language from the main application. This produces a nonsensical text in the main application. Likewise the combination would show **Abir's** inputted text that uses a different language from the language used in the "word processing and other communications". This produces a nonsensical word processing and communications. Thus social benefit result of claim 35 is different than the combination of Martinez and Abir.

7. **Ecology:** Claim 35 has great potential to provide ecology benefits because it does not emphasize or require the printing of paper. Paper is from organic matter, in most cases from trees, which are a limited and important natural resource. Claim 35 is a pure process and the ecology result is critical and different than the combination of Martinez and Abir. Martinez teaches the use of printers, the print function, as well as producing machine parts called a "computer readable storage medium" and "computer-usable medium". Abir teaches producing a machine part called an "apparatus for inputting text". Thus the production of machine parts and the print functions from the combination of Martinez and Abir create significantly more stress on the ecology than claim 35, which is a pure process.

8. **Salability:** Claim 35 recites "presenting a language used in said pop up digital space that is different from the language of said word." Claim 35 is easier to sell and market than the combination of Martinez and Abir. The 2 different languages as recited in claim 35 is educational, are common to many people of different languages and meets the everyday needs of the market. The combination of Martinez and Abir to meet claim 35 likely has no salability results. This is because the combination would show **Martinez's** "similar items" in a language to replace a target item that uses the different language in the main application. Hence Martinez now shows the replacement similar item that is in a different language from the main application. This produces a nonsensical text in the main application. Likewise the combination would show **Abir's** inputted text that uses a different language from the language used in the "word

1

Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.

processing and other communications". This produces a nonsensical word processing and communications. Thus salability of claim 35 is different than the combination of Martinez and Abir.

9. Appearance: Claim 35 provides a better appearing design than the combination of Martinez and Abir because the claim "presents a language used in said pop up digital space that is different from the language of said word." In contrast the combination of Martinez and Abir to meet claim 35 would show a nonsensical and absurd appearance. This is because the combination would show **Martinez's** "similar items" in a language to replace a target item that uses the different language in the main application. Hence Martinez now shows the replacement similar item that is in a different language from the main application. This produces a nonsensical text in the main application. Likewise the combination would show **Abir's** inputted text that uses a different language from the language used in the "word processing and other communications". This produces a nonsensical word processing and communications. Thus the appearance result of claim 35 is different than the combination of Martinez and Abir.

10. Precision: Claim 35 operates and has greater precision because the claim provides "a language used in said pop up digital space that is different from the language of said word." In contrast the combination of Martinez and Abir to meet claim 35 would be nonsensical and absurd. This is because the combination would show **Martinez's** "similar items" in a language to replace a target item that uses the different language in the main application. Hence Martinez now shows the replacement similar item that is in a different language from the main application. This produces a nonsensical text in the main application. Likewise the combination would show **Abir's** inputted text that uses a different language from the language used in the "word processing and other communications". This produces a nonsensical word processing and communications. These nonsensical and absurd results do not provide precision. Thus the precision result of claim 35 is different than the combination of Martinez and Abir.

11. Market Size: Claim 35 likely has a large market size result over the combination of Martinez and Abir. Claim 35 recites "wherein presenting a language used in said pop up digital space that is different from the language of said word." The 2 different languages as recited in claim 35 are common to many people of different languages and meet the everyday needs of this large market. Instead the combination of Martinez and Abir to meet claim 35 would be

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

nonsensical and absurd. This is because the combination would show **Martinez's** "similar items" in a language to replace a target item that uses the different language in the main application. Hence Martinez now shows the replacement similar item that is in a different language from the main application. This produces a nonsensical text in the main application. Likewise the combination would show **Abir's** inputted text that uses a different language from the language used in the "word processing and other communications". This produces a nonsensical word processing and communications. These nonsensical and absurd results have no market size. Thus the market size result of claim 35 is different than the combination of Martinez and Abir.

12. Quality: Claim 35 recites "presenting a language used in said pop up digital space that is different from the language of said word." Claim 35 produces a quality output because its 2 different languages provide a richer quality than one language. In contrast the combination of Martinez and Abir to meet claim 35 would be nonsensical and absurd. This is because the combination would show **Martinez's** "similar items" in a language to replace a target item that uses the different language in the main application. Hence Martinez now shows the replacement similar item that is in a different language from the main application. This produces a nonsensical text in the main application. Likewise the combination would show **Abir's** inputted text that uses a different language from the language used in the "word processing and other communications". This produces a nonsensical word processing and communications. These nonsensical and absurd results provide no quality. Thus claim 35 has a quality result over Martinez.

13. New Use: Claim 35 has discovered a new use for its 2 different languages. Claim 35 provides the new use of "presenting a language used in said pop up digital space that is different from the language of said word." The new use result of claim 35 is different than the combination of Martinez and Abir to meet claim 35. This is because the combination would show **Martinez's** "similar items" in a language to replace a target item that uses the different language in the main application. Hence Martinez now shows the replacement similar item that is in a different language from the main application. This produces a nonsensical text in the main application. Likewise the combination would show **Abir's** inputted text that uses a different language from the language used in the "word processing and other communications".

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

This produces a nonsensical word processing and communications. These nonsensical and
absurd results cannot be produced as a new use. Thus the new use result of claim 35 is different
than the combination of Martinez and Abir.

14. Long Life Cycle: Claim 35 has a potentially long life cycle that can be made and sold for
many years because its 2 different languages are passed from generation to generation. This is
an obvious strong advantage. Instead the combination of Martinez and Abir to meet claim 35
would be nonsensical and absurd. This is because the combination would show **Martinez's**
"similar items" in a language to replace a target item that uses the different language in the main
application. Hence Martinez now shows the replacement similar item that is in a different
language from the main application. This produces a nonsensical text in the main application.
Likewise the combination would show **Abir's** inputted text that uses a different language from
the language used in the "word processing and other communications". This produces a
nonsensical word processing and communications. These nonsensical and absurd results do not
provide a long life cycle. Thus the long life cycle result of claim 35 is different than the
combination of Martinez and Abir.

15. Satisfies Existing Need: Claim 35 satisfies an existing and recognized need. The 2
different languages as recited in claim 35 are common to many people of different languages and
meet the everyday needs of people. Instead the combination of Martinez and Abir to meet claim
35 would be nonsensical and absurd. This is because the combination would show **Martinez's**
"similar items" in a language to replace a target item that uses the different language in the main
application. Hence Martinez now shows the replacement similar item that is in a different
language from the main application. This produces a nonsensical text in the main application.
Likewise the combination would show **Abir's** inputted text that uses a different language from
the language used in the "word processing and other communications". This produces a
nonsensical word processing and communications. These nonsensical and absurd results do not
satisfy an existing need. Thus the existing need result of claim 35 is different than the
combination of Martinez and Abir.

16. Operability: Claim 35 likely will work readily because it is a pure process that is simple
and very useful. Instead the combination of Martinez and Abir to meet claim 35 would be
nonsensical and absurd. This is because the combination would show **Martinez's** "similar

1

Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.

items" in a language to replace a target item that uses the different language in the main
application. Hence Martinez now shows the replacement similar item that is in a different
language from the main application. This produces a nonsensical text in the main application.
Likewise the combination would show **Abir's** inputted text that uses a different language from
the language used in the "word processing and other communications". This produces a
nonsensical word processing and communications. These nonsensical and absurd results make
the combination impracticable and inoperable. Thus the ready operability result of claim 35 is
different than the combination of Martinez and Abir.

17. Profitability: Claim 35 likely is easy to sell at a profit or at an acceptable price level
because its lean structure and pure process requires no expensive and difficult development
tooling or expensive exotic materials to build. The profitability result of claim 35 is different
than the combination of Martinez and Abir because the combination requires expensive tooling
to produce the machine parts of a "computer readable storage medium", "computer-usable
medium" and an "apparatus for inputting text". In addition numerous other elements to build are
discussed in the above subheading "2. Omission of Elements: ". Thus claim 35 has a
profitability advantage result over the combination of Martinez and Abir.

18. Compatibility: Claim 35 is likely to be compatible with existing patterns of use since it is a
pure process and because a word and a pop up digital space are frequently used. Also claim 35 is
likely to be compatible with existing customs because its 2 different languages are common to
people of many languages. In contrast the combination of Martinez and Abir to meet claim 35
would be nonsensical and absurd. This is because the combination would show **Martinez's**
"similar items" in a language to replace a target item that uses the different language in the main
application. Hence Martinez now shows the replacement similar item that is in a different
language from the main application. This produces a nonsensical text in the main application.
Likewise the combination would show **Abir's** inputted text that uses a different language from
the language used in the "word processing and other communications". This produces a
nonsensical word processing and communications. These nonsensical and absurd results provide
no compatibility. Thus the compatibility result of claim 35 is different than the combination of
Martinez and Abir.

o

1

Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.

19. Easy to Promote: Claim 35 is easy to promote because its 2 different languages are common to people of many languages and meets the everyday needs of people. In contrast the combination of Martinez and Abir to meet claim 35 would be nonsensical and absurd. This is because the combination would show **Martinez's** "similar items" in a language to replace a target item that uses the different language in the main application. Hence Martinez now shows the replacement similar item that is in a different language from the main application. This produces a nonsensical text in the main application. Likewise the combination would show **Abir's** inputted text that uses a different language from the language used in the "word processing and other communications". This produces a nonsensical word processing and communications. These nonsensical and absurd results cannot be promoted. In addition claim 35 per se with its pure process and high visibility makes it cheap and easy to market, and this is a clear advantage. Thus the easy to promote result of claim 35 is different than the combination of Martinez and Abir.

20. Combination Product: Claim 35 is a combination product because it recites "presenting a language used in said pop up digital space that is different from the language of said word." Claim 35 and its separate parts of "a language used in said pop up digital space that is different" and "from the language of said word" groove well together. Instead the combination of Martinez and Abir to meet claim 35 would be nonsensical and absurd. This is because the combination would show **Martinez's** "similar items" in a language to replace a target item that uses the different language in the main application. Hence Martinez now shows the replacement similar item that is in a different language from the main application. This produces a nonsensical text in the main application. Likewise the combination would show **Abir's** inputted text that uses a different language from the language used in the "word processing and other communications". This produces a nonsensical word processing and communications. These nonsensical and absurd results do not groove well together. Thus the combination product result of claim 35 is different than the combination of Martinez and Abir.

21. Broad Patent Coverage Available: Claim 35 recites "presenting a language used in said pop up digital space that is different from the language of said word." Claim 35 likely will have broad patent coverage available if allowed and this will affect profitability. Since claim 35 is the only source which performs its certain, unique functions, the claim will be able to charge more

1

Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.

than if it were in a competitive situation. Instead the combination of Martinez and Abir to meet claim 35 would be nonsensical and absurd. This is because the combination would show **Martinez's** "similar items" in a language to replace a target item that uses the different language in the main application. Hence Martinez now shows the replacement similar item that is in a different language from the main application. This produces a nonsensical text in the main application. Likewise the combination would show **Abir's** inputted text that uses a different language from the language used in the "word processing and other communications". This produces a nonsensical word processing and communications. These nonsensical and absurd results make the combination not functional and not usable. Thus claim 35 has broad patent coverage over the combination of Martinez and Abir.

22. **High Sales Anticipated:** Claim 35 per se can anticipate a high sales volume because its 2 different languages are common to people of many languages and meets their everyday needs. In contrast the combination of Martinez and Abir to meet claim 35 would be nonsensical and absurd. This is because the combination would show **Martinez's** "similar items" in a language to replace a target item that uses the different language in the main application. Hence Martinez now shows the replacement similar item that is in a different language from the main application. This produces a nonsensical text in the main application. Likewise the combination would show **Abir's** inputted text that uses a different language from the language used in the "word processing and other communications". This produces a nonsensical word processing and communications. These nonsensical and absurd results from the combination do not anticipate high sales. Thus high sales anticipated result of claim 35 is different than the combination of Martinez and Abir.

23. **Youth Market:** Young people have substantial discretionary income and tend to spend more in many product areas than the rest of the population, and computers are popular with this age group. Claim 35 will likely appeal to young people because it's "a language used in said pop up digital space that is different from the language of said word" is very useful for them to learn about a word in a different language. Claim 35 is important for the purposes of learning and education. Claim 35 is valuable because higher education is often a priority of young people. Claim 35 likely will command more sales of the youth market than the combination of Martinez and Abir. The combination of Martinez and Abir to meet claim 35 would be nonsensical and

1

Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.

absurd. This is because the combination would show **Martinez's** "similar items" in a language

to replace a target item that uses the different language in the main application. Hence Martinez

now shows the replacement similar item that is in a different language from the main application.

This produces a nonsensical text in the main application. Likewise the combination would show

Abir's inputted text that uses a different language from the language used in the "word

processing and other communications". This produces a nonsensical word processing and

communications. These nonsensical and absurd results will not appeal to the youth market.

Thus the youth market result of claim 35 is different than the combination of Martinez and Abir.

24. Synergism: Claim 35 recites "presenting a language used in said pop up digital space that is

different from the language of said word." The result achieved by claim 35 and its 2 different

languages is greater than the sum of the separate results of its parts of "said word" and "said pop

up digital space". The parts of claim 35 cooperate together to increase the overall learning of a

word in a different language, a synergistic effect. In contrast the combination of Martinez and

Abir to meet claim 35 would be nonsensical and absurd. This is because the combination would

show **Martinez's** "similar items" in a language to replace a target item that uses the different

language in the main application. Hence Martinez now shows the replacement similar item that

is in a different language from the main application. This produces a nonsensical text in the

main application. Likewise the combination would show **Abir's** inputted text that uses a

different language from the language used in the "word processing and other communications".

This produces a nonsensical word processing and communications. These nonsensical and

absurd results are not a synergistic effect. Thus the synergism result of claim 35 is different than

the combination of Martinez and Abir.

25. Unexpected Result: The results achieved by claim 35 are new, unexpected, superior,

disproportionate, unusual, unsuggested, critical and surprising because it provides "a language

used in said pop up digital space that is different from the language of said word." These results

of claim 35 did not exist as of the applicant's filing date. In contrast the combination of

Martinez and Abir to meet claim 35 would be nonsensical and absurd. This is because the

combination would show **Martinez's** "similar items" in a language to replace a target item that

uses the different language in the main application. Hence Martinez now shows the replacement

similar item that is in a different language from the main application. This produces a

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

nonsensical text in the main application. Likewise the combination would show **Abir's** inputted

text that uses a different language from the language used in the "word processing and other

communications". This produces a nonsensical word processing and communications. These

nonsensical and absurd results make the combination impracticable. Thus the unexpected results

of claim 35 are different than the combination of Martinez and Abir.

26. Crowded Art: Claim 35 is classified in the crowded art of computers, and therefore a small

step forward should be regarded as significant. Claim 35 provides the small step forward of

"presenting a language used in said pop up digital space that is different from the language of

said word" in the crowded art. Instead the combination of Martinez and Abir to meet claim 35

would be nonsensical and absurd and is not a step forward in the crowded art.

27. Unsuggested Modification: Martinez and Abir lack any suggestion that their inventions

should be modified in a manner required to meet claim 35. Claim 35 recites "presenting a

language used in said pop up digital space that is different from the language of said word."

Martinez does not teach a "language" of claim 35 anywhere in his invention. Both Martinez and

Abir do not teach the 2 different languages as recited in claim 35 anywhere in their inventions.

Further the combination of Martinez and Abir to meet claim 35 would be nonsensical and

absurd. This is because the combination would show **Martinez's** "similar items" in a language

to replace a target item that uses the different language in the main application. Hence Martinez

now shows the replacement similar item that is in a different language from the main application.

This produces a nonsensical text in the main application. Likewise the combination would show

Abir's inputted text that uses a different language from the language used in the "word

processing and other communications". This produces a nonsensical word processing and

communications. These nonsensical and absurd results make the combination an unsuggested

modification of Martinez and Abir. Thus the combination of Martinez and Abir clearly lacks any

suggestion that their inventions should be modified in a manner to meet claim 35.

28. Poor References: Claim 35 recites "presenting a language used in said pop up digital space

that is different from the language of said word." Martinez is entirely foreign to claim 35

because he does not teach a "language" of the claim. Martinez and Abir do not teach the 2

different languages as recited in claim 35 anywhere in their inventions. Further the combination

of Martinez and Abir to meet claim 35 is foreign and conflicting to the claim since the

1

combination would be nonsensical and absurd. This is because the combination would show **Martinez's** "similar items" in a language to replace a target item that uses the different language in the main application. Hence Martinez now shows the replacement similar item that is in a different language from the main application. This produces a nonsensical text in the main application. Likewise the combination would show **Abir's** inputted text that uses a different language from the language used in the "word processing and other communications". This produces a nonsensical word processing and communications. These nonsensical and absurd results make the combination a poor reference.

Even if Martinez and Abir were to be combined in the manner suggested from the O.A., the combination is still foreign and conflicts with claim 35 since such a combination does not teach "a language translator" feature.

Therefore the combination of Martinez and Abir is a weak reference to claim 35 and should be construed narrowly.

29. Ancient Suggestion: The O.A., regarding the suggested combination of Martinez and Abir, stated "Abir shows that a language translator feature could be added to an electronic dictionary (claims 13-15, col. 8)."

Abir does **not** teach "a language translator" and "an electronic dictionary" in his claims 13-15 and at his col. 8, or anywhere in his invention. Nevertheless the suggestion to add the language translator and electronic dictionary to Martinez is many years old. Further to add the language translator and electronic dictionary to the combination of Martinez and Abir to meet claim 35 was never implemented and would produce greatly inferior results. This is because the combination would show **Martinez's** "similar items" in a language to replace a target item that uses the different language in the main application. Hence Martinez now shows the replacement similar item that is in a different language from the main application. This produces a nonsensical text in the main application. Likewise the combination would show **Abir's** inputted text that uses a different language from the language used in the "word processing and other communications". This produces a nonsensical word processing and communications. These nonsensical and absurd results are greatly inferior to claim 35.

In contrast claim 35 recites "presenting a language used in said pop up digital space that is different from the language of said word." Claim 35 provides a unique, convenient process for a

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

person to learn about a word in a different language. Thus to add "a language translator" and an "electronic dictionary" is an ancient suggestion that is different than claim 35.

30. Misunderstood References: The combination of Martinez and Abir does **not** teach what the O.A. relies upon it as supposedly teaching. The O.A., regarding the suggested combination of Martinez and Abir, stated "Abir shows that a language translator feature could be added to an electronic dictionary (claims 13-15, col. 8)."

<u>Abir does **not** teach "a language translator" and "an electronic dictionary" in his claims 13-15 and at his col. 8, or anywhere in his invention. The combination does not need a "dictionary" in order to teach claim 35.</u>

Further since claim 35 recites "presenting a language used in said pop up digital space that is different from the language of said word", the combination of Martinez and Abir to meet the claim would be nonsensical and absurd. This is because the combination would show **Martinez's** "similar items" in a language to replace a target item that uses the different language in the main application. Hence Martinez now shows the replacement similar item that is in a different language from the main application. This produces a nonsensical text in the main application. Likewise the combination would show **Abir's** inputted text that uses a different language from the language used in the "word processing and other communications". This produces a nonsensical word processing and communications. Thus these nonsensical and absurd results from the combination make Martinez and Abir misunderstood references to claim 35.

31. Lack of Implementation: If claim 35 were in fact obvious, because of its advantages, Martinez, Abir and those skilled in the art surely would have implemented the claim as of the applicant's filing date. Claim 35 recites "presenting a language used in said pop up digital space that is different from the language of said word." Even if Martinez and Abir were combined to meet claim 35 the result would be nonsensical and absurd. This is because the combination would show **Martinez's** "similar items" in a language to replace a target item that uses the different language in the main application. Hence Martinez now shows the replacement similar item that is in a different language from the main application. This produces a nonsensical text in the main application. Likewise the combination would show **Abir's** inputted text that uses a different language from the language used in the "word processing and other communications".

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

This produces a nonsensical word processing and communications. These nonsensical and absurd results are the reason that Martinez and Abir could not be implemented to meet claim 35. The fact that Martinez, Abir and those skilled in the art have not implemented claim 35, despite its great advantages, indicates that it is not obvious.

32. Contrarian Invention: Claim 35 recites "presenting a language used in said pop up digital space that is different from the language of said word." Claim 35 is contrary to the teachings of the combination of Martinez and Abir because the claim provides a unique, convenient process for a person to learn about a word in a different language. Instead the combination of Martinez and Abir to meet claim 35 would be nonsensical and absurd. This is because the combination would show **Martinez's** "similar items" in a language to replace a target item that uses the different language in the main application. Hence Martinez now shows the replacement similar item that is in a different language from the main application. This produces a nonsensical text in the main application. Likewise the combination would show **Abir's** inputted text that uses a different language from the language used in the "word processing and other communications". This produces a nonsensical word processing and communications. Claim 35 goes against these nonsensical and absurd results from the combination. Thus claim 35 is contrarian to the combination of Martinez and Abir.

33. Strained Interpretation: The O.A. has made a strained interpretation of Martinez and Abir that could only be made by hindsight. The O.A., regarding the combination of Martinez and Abir, stated "Abir shows that a language translator feature could be added to an electronic dictionary (claims 13-15, col. 8)."

<u>Abir does **not** teach "a language translator" and "an electronic dictionary" in his claims 13-15 and at his col. 8, or anywhere in his invention. The combination does not need a "dictionary" in order to teach claim 35.</u>

Further since claim 35 recites "presenting a language used in said pop up digital space that is different from the language of said word", the combination of Martinez and Abir to meet claim 35 would be nonsensical and absurd. This is because the combination would show **Martinez's** "similar items" in a language to replace a target item that uses the different language in the main application. Hence Martinez now shows the replacement similar item that is in a different language from the main application. This produces a nonsensical text in the main application.

1

Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.

Likewise the combination would show **Abir's** inputted text that uses a different language from the language used in the "word processing and other communications". This produces a nonsensical word processing and communications. Thus these nonsensical and absurd results from the combination are a strained interpretation of Martinez and Abir to meet claim 35.

34. Solved Different Problem: Claim 35 solves a different problem than the combination of Martinez and Abir, and such different problem is recited in the claim. Claim 35 recites "presenting a language used in said pop up digital space that is different from the language of said word." Claim 35 solves the educational problem of learning about a word in a different language. In contrast the combination of Martinez and Abir to meet claim 35 would be nonsensical and absurd and this does not solve any problem. This is because the combination would show **Martinez's** "similar items" in a language to replace a target item that uses the different language in the main application. Hence Martinez now shows the replacement similar item that is in a different language from the main application. This produces a nonsensical text in the main application. Likewise the combination would show **Abir's** inputted text that uses a different language from the language used in the "word processing and other communications". This produces a nonsensical word processing and communications. These nonsensical and absurd results do not solve the educational problem of claim 35 and in fact creates more unnecessary problems. Thus claim 35 is different than the combination of Martinez and Abir because the combination does not solve any problem.

35. No Convincing Reasoning: The O.A. has not presented a convincing line of reasoning as to why the subject matter of claim 35 as a whole, including its differences over the combination of Martinez and Abir, would have been obvious. The O.A., regarding the combination of Martinez and Abir, stated "Abir shows that a language translator feature could be added to an electronic dictionary (claims 13-15, col. 8)."

Abir does not teach "a language translator" and "an electronic dictionary" in his claims 13-15 and at his col. 8, or anywhere in his invention. The combination does not need a "dictionary" in order to teach claim 35.

Further since claim 35 recites "presenting a language used in said pop up digital space that is different from the language of said word", the combination of Martinez and Abir to meet claim 35 would be nonsensical and absurd. This is because the combination would show **Martinez's**

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

"similar items" in a language to replace a target item that uses the different language in the main application. Hence Martinez now shows the replacement similar item that is in a different language from the main application. This produces a nonsensical text in the main application. Likewise the combination would show **Abir's** inputted text that uses a different language from the language used in the "word processing and other communications". This produces a nonsensical word processing and communications. Thus these nonsensical and absurd results from the combination are not a convincing line of reasoning that claim 35 would have been obvious.

From the reasons discussed, the applicant submits that claim 35 produces valuable new, unexpected, and different results and hence is unobvious and patentable over the combination of Martinez and Abir under 35 U.S.C § 103, and <u>requests</u> reconsideration. Accordingly the applicant submits that dependent claim 35 is a fortiori patentable and <u>requests its allowance.</u>

Regarding Claims 39-53 from Previous Amendment C

As mentioned, the O.A. stated that claims 39-53 "are withdrawn from consideration as being directed to a non-elected invention.".

Claims 39-53 are in withdrawn status.

A Review of the Reference of Martinez: Martinez is discussed in the above heading "A Review of the Reference of Martinez:".

New Independent Claim 54 is Submitted Under § 112

New independent claim 54 recites:

"A system of providing dictionary content for a word, comprising:

> a computer,
>
> a word displayed on a screen,
>
> a pop up digital space on said screen,
>
> a dictionary element for said word on said screen, and
>
> displaying said pop up digital space to present said dictionary element on said screen when a cursor is placed over said word."

Claim 54 is newly added in the following ways with the accompanying reasons:

1. The preamble "A system of providing dictionary content for a word, comprising:" is added to summarize claim 54, and to make the claim clear and logical under § 112, second paragraph.

1

<u>Lee DeGross   Appn. Number 10/081.579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

2. The "a computer, a word displayed on a screen, a pop up digital space on said screen," is added to make claim 54 clear, precise and logical under § 112, second paragraph.

3. The "a dictionary element for said word on said screen, and" is added to make claim 54 clear, precise and logical under § 112, second paragraph.

4. The "displaying said pop up digital space to present said dictionary element on said screen when a cursor is placed over said word." is added to make claim 54 clear, precise and logical under § 112, second paragraph.

The applicant submits that new claim 54 distinctly claims the subject matter and is clear and understandable. No new matter has been added and the subject matter of the claim is supported in the applicant's specification.

Therefore, the applicant requests allowance of new claim 54 under 35 U.S.C. § 112.

New Independent Claim 54 is Patentable Over Martinez Under § 102 and Under § 103

New independent claim 54 recites substantially the same subject matter as previously presented independent claim 24. The same reasons that claim 24 is patentable over Martinez is applied to new claim 54, except for the slightly different terms and deleted lettered subparagraphs.

The reasons are discussed in the above headings of "The Rejection of Independent Claim 24 on Martinez Overcome Under § 102" and "Claim 24 Produces New and Unexpected Results and Hence is Unobvious and Patentable Over Martinez Under § 103".

Therefore, the applicant submits that independent claim 54 is patentable over Martinez and requests its allowance.

A Review of the Reference of Martinez: Martinez is discussed in the above heading "A Review of the Reference of Martinez:".

New Dependent Claim 55 is Submitted Under § 112

New dependent claim 55 recites: "The system of Claim 54 wherein displaying said dictionary element that includes a definition presented in said pop up digital space."

Claim 55 is newly added in the following ways with the accompanying reasons:

1. The "The system of Claim 54" is added to recite the title of referred claim 54, and to make claim 55 clear, precise and logical under § 112, second paragraph.

1

Lee DeGross   Appn. Number 10/081.579   Exam. Group/Art Unit 2626   Amnt. 116 contd.

2. The "wherein displaying said dictionary element that includes a definition presented in said pop up digital space." is added to make claim 55 clear, precise and logical under § 112, second paragraph.

The applicant submits that new claim 55 distinctly claims the subject matter and is clear and understandable. No new matter has been added and the subject matter of the claim is supported in the applicant's specification.

Therefore, the applicant requests allowance of new claim 55 under 35 U.S.C. § 112.

New Independent Claim 55 is Patentable Over Martinez Under § 102 and Under § 103

New dependent claim 55 recites substantially the same subject matter as previously presented dependent claim 25. The same reasons that claim 25 is patentable over Martinez is applied to new claim 55, except for the slightly different terms.

The reasons are discussed in the above headings of "The Rejection of Dependent Claim 25 on Martinez Overcome Under § 102" and "Dependent Claim 25 Is A Fortiori Patentable Over Martinez".

Therefore, the applicant submits that dependent claim 55 is patentable over Martinez and requests its allowance.

A Review of the Reference of Martinez: Martinez is discussed in the above heading "A Review of the Reference of Martinez:".

New Dependent Claim 56 is Submitted Under § 112

New dependent claim 56 recites: "The system of Claim 54 wherein displaying said pop up digital space presents a video when said cursor is placed over said word."

Claim 56 is newly added in the following ways with the accompanying reasons:

1. The "The system of Claim 54" is added to recite the title of referred claim 54, and to make claim 56 clear, precise and logical under § 112, second paragraph.

2. The "wherein displaying said pop up digital space presents a video when said cursor is placed over said word." is added to make claim 56 clear, precise and logical under § 112, second paragraph.

The applicant submits that new claim 56 distinctly claims the subject matter and is clear and understandable. No new matter has been added and the subject matter of the claim is supported in the applicant's specification.

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

Therefore, the applicant requests allowance of new claim 56 under 35 U.S.C. § 112.

New Independent Claim 56 is Patentable Over Martinez Under § 102 and Under § 103

New dependent claim 56 recites substantially the same subject matter as currently amended

dependent claim 27. The same reasons that claim 27 is patentable over Martinez is applied to

new claim 56, except for the slightly different terms.

The reasons are discussed in the above headings of "The Rejection of Dependent Claim 27 on

Martinez Overcome Under § 102" and "Dependent Claim 27 Is A Fortiori Patentable Over

Martinez".

Therefore, the applicant submits that dependent claim 56 is patentable over Martinez and

requests its allowance.

A Review of the Reference of Martinez: Martinez is discussed in the above heading "A

Review of the Reference of Martinez:".

New Dependent Claim 57 is Submitted Under § 112

New dependent claim 57 recites: "The system of Claim 54 wherein having said dictionary

element that presents more than one meaning of said word, the intended contextual meaning of

said word is highlighted."

Claim 57 is newly added in the following ways with the accompanying reasons:

1. The "The system of Claim 54" is added to recite the title of referred claim 54, and to make

claim 57 clear, precise and logical under § 112, second paragraph.

2. The "wherein having said dictionary element that presents more than one meaning of said

word, the intended contextual meaning of said word is highlighted." is added to make claim 57

clear, precise and logical under § 112, second paragraph.

The applicant submits that new claim 57 distinctly claims the subject matter and is clear and

understandable. No new matter has been added and the subject matter of the claim is supported

in the applicant's specification.

Therefore, the applicant requests allowance of new claim 57 under 35 U.S.C. § 112.

New Independent Claim 57 is Patentable Over Martinez Under § 102 and Under § 103

New dependent claim 57 recites substantially the same subject matter as currently amended

dependent claim 29. The same reasons that claim 29 is patentable over Martinez is applied to

new claim 57, except for the slightly different terms.

1

<u>Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.</u>

The reasons are discussed in the above headings of "The Rejection of Dependent Claim 29 on Martinez Overcome Under § 102" and "Dependent Claim 29 Is A Fortiori Patentable Over Martinez".

Therefore, the applicant submits that dependent claim 57 is patentable over Martinez and requests its allowance.

A Review of the Reference of Martinez: Martinez is discussed in the above heading "A Review of the Reference of Martinez:".

New Dependent Claim 58 is Submitted Under § 112

New dependent claim 58 recites: "The system of Claim 54 wherein displaying said dictionary element that is presented with respect to an intended audience."

Claim 58 is newly added in the following ways with the accompanying reasons:

1. The "The system of Claim 54" is added to recite the title of referred claim 54, and to make claim 58 clear, precise and logical under § 112, second paragraph.

2. The "wherein displaying said dictionary element that is presented with respect to an intended audience." is added to make claim 58 clear, precise and logical under § 112, second paragraph.

The applicant submits that new claim 58 distinctly claims the subject matter and is clear and understandable. No new matter has been added and the subject matter of the claim is supported in the applicant's specification.

Therefore, the applicant requests allowance of new claim 58 under 35 U.S.C. § 112.

New Independent Claim 58 is Patentable Over Martinez Under § 102 and Under § 103

New dependent claim 58 recites substantially the same subject matter as currently amended dependent claim 32. The same reasons that claim 32 is patentable over Martinez is applied to new claim 58, except for the slightly different terms.

The reasons are discussed in the above headings of "The Rejection of Dependent Claim 32 on Martinez Overcome Under § 102" and "Dependent Claim 32 Is A Fortiori Patentable Over Martinez".

Therefore, the applicant submits that dependent claim 58 is patentable over Martinez and requests its allowance.

1

Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.

A Review of the References of Martinez and Abir: Martinez is discussed in the above heading "A Review of the Reference of Martinez:". Abir is discussed in the above heading "A Review of the Reference of Abir:".

New Dependent Claim 59 is Submitted Under § 112

New dependent claim 59 recites: "The system of Claim 54 wherein presenting a language used in said pop up digital space that is different from the language of said word."

Claim 59 is newly added in the following ways with the accompanying reasons:

1. The "The system of Claim 54" is added to recite the title of referred claim 54, and to make claim 59 clear, precise and logical under § 112, second paragraph.

2. The "wherein presenting a language used in said pop up digital space that is different from the language of said word." is added to make claim 59 clear, precise and logical under § 112, second paragraph.

The applicant submits that new claim 59 distinctly claims the subject matter and is clear and understandable. No new matter has been added and the subject matter of the claim is supported in the applicant's specification.

Therefore, the applicant requests allowance of new claim 59 under 35 U.S.C. § 112.

New Independent Claim 59 is Patentable Over Martinez Under § 102 and Under § 103

New dependent claim 59 recites substantially the same subject matter as previously presented dependent claim 35. The same reasons that claim 35 is patentable over Martinez and the combination of Martinez and Abir is applied to new claim 59, except for the slightly different terms.

The reasons are discussed in the above headings of "The Rejection of Dependent Claim 35 on Martinez Overcome Under § 102" and "Dependent Claim 35 is Rejected on Martinez and Abir Under 35 U.S.C. 103" and "Dependent Claim 35 Is A Fortiori Patentable Over the Combination of Martinez and Abir".

Therefore, the applicant submits that dependent claim 59 is novel over Martinez and unobvious over the combination of Martinez and Abir and requests its allowance.

Conditional Request for Constructive Assistance

The applicant has amended the claims of this application so that they are proper, definite, and define novel physical features which are also unobvious. If, for any reason this application is not

105

Lee DeGross   Appn. Number 10/081,579   Exam. Group/Art Unit 2626   Amnt. 116 contd.

believed to be in full condition for allowance, the applicant respectfully requests the constructive assistance and suggestions of the Examiner pursuant to M.P.E.P. § 2173.02 and § 707.07(j) in order that the undersigned can place this application in allowable condition as soon as possible and without the need for further proceedings.

Conclusion

For all the reasons given above, the applicant respectfully submits that the claims comply with § 112, the claims define over the prior art under § 102, and the claimed distinctions are of patentable merit under § 103 because of the new results of: a pop up digital space presents a dictionary element for a word such as a definition or a video when a cursor is simply placed over the word in a fast and convenient manner. Also the intended contextual meaning of a word is highlighted when there is more than one meaning presented in a pop up digital space.   In addition a dictionary element is presented with respect to an intended audience, and the language used in a pop up digital space is different from the language of a word in the text. Accordingly, the applicant submits that this application is now in full condition for allowance, which action the applicant respectfully requests.

Very respectfully,

Lee DeGross

400 Park Place, #1H
Fort Lee, NJ 07024
Tel. (201) 592-9999

Certificate of Facsimile Transmission. I certify that on the date below I will fax this communication, and attachments, to Group 2626 of the Patent and Trademark Office at the following number: 571-273-8300.

2011 Sept. 21

Inventor's Signature: _____